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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91162370
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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De Boulle Diamond & Jewelry, Inc.,

Opposer,

v.

De Beers LV Ltd.,

Applicant.

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: Consolidated Opposition No.: 91162370  
: Opposition Nos. 91162370  
: 91162469  
: 91164615  
: 91165285  
: 91165465  
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**APPLICANT'S CROSS-MOTION FOR PARTIAL  
SUMMARY JUDGMENT AND RESPONSE IN OPPOSITION  
TO OPPOSER'S MOTION FOR SUMMARY JUDGMENT**

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**APPLICANT'S CROSS-MOTION FOR PARTIAL  
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TO OPPOSER'S MOTION FOR SUMMARY JUDGMENT**

Applicant, De Beers LV Ltd. (hereinafter "De Beers or Applicant"), by and through its counsel, pursuant to Fed. R. Civ. P. 56 and 37 C.F.R. § 2.127, hereby cross-moves for partial Summary Judgment and responds to Opposer's, De Boulle Diamond & Jewelry, Inc. (hereinafter "De Boulle or Opposer"), Motion for Summary Judgment ("Opp. Mot.").

**I. PRELIMINARY STATEMENT**

These consolidated opposition proceedings are based on two registered marks owned by Opposer, namely, the word mark "DE BOULLE" and a design mark "deB and Design", and one claimed trademark "DB", which is not registered. De Boulle opposes registration of De Beers' trademarks "DB STAR", "DB LOGO", "DB MONOGRAM", "DB SIGNATURE" and "SO DB" based on Section 2(d) of the Lanham Act. All of the subject marks are for goods that include expensive diamond jewelry.

With regard to Opposer's registered trademarks "DE BOULLE" and "deB and Design", summary judgment should be granted in De Beers' favor, as there are no material facts in dispute and there is no likelihood of confusion as a matter of law. In particular, the parties' respective marks are visually and aurally distinct and convey entirely different commercial impressions. In addition, there is no dispute that the goods involved herein--luxury, high-end diamonds and jewelry--are expensive goods and that the typical purchasers are discriminating and sophisticated. Therefore, purchasers of the parties' products will exercise due care when making purchasing decisions. For these reasons, there is no likelihood of confusion between the two registered De Boulle marks and the five De Beers marks as a matter of law, and therefore, the Board should grant summary judgment to De Beers.

With regard to De Boulle's claimed "DB" trademark, there are serious, bona fide issues of material fact. De Boulle's claim of trademark rights in "DB" is suspect for a number of reasons, and the facts regarding De Boulle's alleged use of "DB" as a trademark are in dispute. Notably, De Boulle did not make any mention of the supposed "DB" trademark in either of its first two Notices of Opposition filed on September 27, 2004, even though De Boulle claims that it first used "DB" as a trademark on December 31, 2000. Clearly, if De Boulle was actually using "DB" as a trademark, this is the first mark it would have mentioned in its Notices of Opposition against the marks "DB LOGO" and "DB MONOGRAM".

Moreover, although De Boulle filed applications to register its trademarks "DE BOULLE" and "deB and Design" on July 1, 2004--before it instituted the first of these five consolidated opposition proceedings--De Boulle's application to register "DB" appears to have been an afterthought, as it was filed after De Boulle had instituted the third of these opposition proceedings.

More importantly, De Boulle has totally failed to establish by competent evidence when or how it has allegedly used “DB” as a trademark. The *only* evidence it presents on its motion is the affidavit of its CEO and Chairman, Denis J. Boulle, who is clearly a biased witness. Moreover, Mr. Boulle’s testimony is vague and indefinite; he does not even claim that De Boulle used “DB” as a trademark on packaging or hangtags in connection with any specific goods. Further, Mr. Boulle does not proffer any corroborating evidence--either testimonial or documentary--regarding his company’s claimed “DB” trademark. The only document referenced by Mr. Boulle regarding the “DB” mark is a web site printout which was rejected by the Examining Attorney on De Boulle’s application to register DB as being an improper specimen of use. Therefore, under the record presently before the Board, the only date upon which De Boulle can rely on for its “DB” mark is the application filing date of April 7, 2005, which post-dates the filing dates of all five of the De Beers marks. Clearly, there are issues of material fact regarding the alleged “DB” mark.

Accordingly, under the summary judgment standard in which it is De Boulle’s burden to demonstrate no genuine issue of material fact, and under which the Board must view the evidence in a light most favorable to De Beers, summary judgment with regard to the claimed “DB” trademark should be denied.

## **II. FACTS**

### **A. Procedural Background**

#### **1. De Beers’ Federal Trademark Applications.**

De Beers filed federal trademark applications for the following marks on the following dates:

- 1) “DB SIGNATURE” - May 2, 2003 (U.S. Application Serial No. 78/245,210);
- 2) “DB LOGO” - May 2, 2003 (U.S. Application Serial No. 78/245,219);
- 3) “DB STAR” - May 5, 2003 (U.S. Application Serial No. 78/245,795);
- 4) “DB MONOGRAM” - May 5, 2003 (U.S. Application Serial No. 78/245,779); and
- 5) “SO DB” - November 25, 2003 (U.S. Application Serial No. 79/000,478).


Trademark application numbers 1 - 4 were filed based on Section 44(e) of the Trademark Act, 15 U.S.C. § 1126(e). Application number 5 was filed based on Section 66(a) of the Trademark Act, 15 U.S.C. § 1141(f).

De Beers’ five federal trademark registrations were published in the *Official Gazette* on the following dates: 1) “DB MONOGRAM” - June 1, 2004 (U.S. Application Serial No. 78/245,779); 2) “DB LOGO” - August 17, 2004 (U.S. Application Serial No. 78/245,219); 3) “DB SIGNATURE” - March 8, 2005 (U.S. Application Serial No. 78/245,210); 4) “DB STAR” - May 3, 2005 (U.S. Application Serial No. 78/245,795); and 5) “SO DB” - May 3, 2005 (U.S. Application Serial No. 79/000,478).

## **2. Opposer’s Federal Trademark Applications.**

On July 1, 2004, Opposer filed for two federal trademark registrations for “DE BOULLE” (U.S. Application Serial No. 78/444,880) and “deB and Design” (U.S. Application Serial No. 78/444,907) based on Section 1(a) of the U.S. Trademark Act, 15 U.S.C. § 1051(a). Opposer’s trademark applications for “DE BOULLE” and “deB and Design” matured to registration on April 11, 2006.

On April 7, 2005, Opposer filed for a federal trademark registration for “DB” (U.S. Application Serial No. 78/604,056) based on Section 1(a) of the U.S. Trademark Act, 15 U.S.C. § 1051(a). The “DB” application is currently suspended pending the disposition of this consolidated proceeding<sup>1</sup>, as well as a civil action in the U.S. District Court of the Northern District of Texas, captioned *De Boulle Diamond & Jewelry, Inc. v. Colibri Corp.*, Civil Action No. 3:06-CV-0794-M, in which Opposer is seeking to cancel U.S. Registration No. 1,391,538 for a stylized DB mark for jewelry.<sup>2</sup> See Declaration of Darren W. Saunders (hereinafter “Saunders Decl.”) ¶ 3, Exhibit A. Opposer’s marks are shown below:

Reg. No. 3,078,625	Reg. No. 3,078,627	Appl. Serial No. 78/604,056
DE BOULLE		DB

### 3. The Instant Opposition Proceedings.

On September 27, 2004, Opposer commenced these opposition proceedings by filing two Notices of Opposition against De Beers’ trademark application for “DB LOGO” (Opposition No. 91162370) and “DB MONOGRAM” (Opposition No. 91162469). These two oppositions were based solely on alleged prior rights in the “deB and Design” mark (U.S. Application Serial No. 78/444,907). (Opposer made no mention of its alleged “DB” mark even

<sup>1</sup> De Beers’ trademark applications for “DB MONOGRAM” (Serial No. 78/245,779), “DB LOGO” (Serial No. 78/245,219), “DB SIGNATURE” (Serial No. 78/245,210) and “DB STAR” (Serial No. 78/245,795) were cited as prior pending applications against the “DB” mark based on Section 2(d) of the Lanham Act.

<sup>2</sup> De Boulle commenced the above-referenced civil action for cancellation of the trademark “DB and Design” (Registration No. 1,391,538), which was cited as a bar to the registration of Opposer’s “DB” mark based on Section 2(d) of the Lanham Act. The action is based on alleged abandonment. If De Boulle’s cancellation action is not successful, Opposer will not have standing to pursue this consolidated proceeding with respect to the “DB” mark.

though it claims use of the mark as of December 31, 2000). Opposer filed a third Notice of Opposition on March 14, 2005 against De Beers' trademark application for "DB SIGNATURE" (Opposition No. 91164615). In its third Notice of Opposition, Opposer stated that it "has for many years used "DB" and "deB" marks" and "has used a particular stylized version of the "deB" mark, which is a "deB" logo, since at least as early as June 30, 2001." Opposer did not allege a date of first use for the "DB" mark. On May 2, 2007, the Board *sua sponte* consolidated Opposition Nos. 91162370, 91162469 and 91164615 under Opposition No. 91162370.

Opposer filed its fourth and fifth Notices of Opposition against De Beers' "DB STAR" (Opposition No. 91165285) and "SO DB" (Opposition No. 91165465) on May 13, 2005. In these Notices of Opposition, Opposer based its alleged rights on the "DB" and "deB and Design" marks, and for the first time, asserted a date of first use for the "DB" mark as of December 31, 2000.<sup>3</sup> On July 20, 2005, the Board *sua sponte* consolidated Opposition Nos. 91165285 and 91165465 with the previous Consolidated Opposition No. 91162370, as Consolidated Opposition No. 91165285. (hereinafter the "Consolidated Proceeding"). By Order on the same date, the Board reset discovery and trial dates.

#### **4. Discovery in the Consolidated Proceeding.**

On July 27, 2005, Opposer served its first discovery documents on De Beers. De Beers timely responded to Opposer's interrogatories on October 3, 2005 and produced documents during the discovery period. On November 8, 2005, De Beers served its first discovery documents on Opposer, including its Interrogatories, Requests for Admission and

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<sup>3</sup> Curiously, although Opposer claimed a date of first use of "DB" as of December 31, 2000, it did not file a trademark application until April 7, 2005, after filing its third Notice of Opposition and well after filing its trademark applications for "DE BOULLE" and "deB and Design".

Documents Requests. De Beers purposefully awaited production of De Boulle's documents before noticing and taking the deposition of a De Boulle representative. Opposer was uncooperative with regard to producing its documents. Despite De Beers' repeated efforts to obtain De Boulle's documents, Opposer failed to produce any documents during the discovery period.<sup>4</sup>

Months passed without any response from De Boulle to De Beers' multiple correspondence regarding discovery. Also, as De Boulle had not filed a response to De Beers' Motion to Compel, De Beers concluded that De Boulle had lost interest in prosecuting the opposition proceedings. Accordingly, De Beers purposefully did not expend any further time on the matter. Thereafter, suddenly, on January 31, 2007, Opposer filed a Request for Substitution of Lead Counsel and a Response to De Beers' Motion for Discovery Sanctions. In addition, Opposer's new counsel filed a Motion to Reopen Discovery and Testimony Periods and a Motion to Compel Responses to Discovery, on February 9, 2007 and February 12, 2007, respectively. Also, on February 9, 2007 De Boulle produced documents in response to De Beers' requests that were served on November 8, 2005.

The Board denied both De Beers' Motion for Sanctions and Opposer's Motion to Reopen Discovery by Order dated July 9, 2007, but granted Opposer's motion to re-open the testimony periods. Opposer's opening testimony period was reset to close on September 15, 2007.

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<sup>4</sup> De Beers believed that it was critical to await receipt of the requested documents before taking any discovery depositions so that it could question De Boulle about the documents. De Beers communicated this to De Boulle on several occasions in writing during the discovery period, but De Boulle did not comply with its obligations, ultimately forcing De Beers to file a Motion to Compel and a Motion for Discovery Sanctions. Opposer finally produced its documents 15 months after De Boulle's requests were served and over eight months after the close of discovery.



**5. Opposer's Motion for Summary Judgment.**

On August 9, 2007, Opposer filed its Motion for Summary Judgment. Opposer submitted one supporting affidavit with its Memorandum of Law. The affiant, Denis Boulle, is the Chief Executive Officer and Chairman of the Board of De Boulle. Mr. Boulle is also a former president of De Boulle. In view of De Boulle's months of silence and lack of cooperation in discovery, as well as De Beers being suddenly confronted with Mr. Boulle's uncorroborated testimony, on September 17, 2007, De Beers made a request pursuant to Fed. R. Civ. P. 56(f) to cross-examine Mr. Boulle on the substance of his affidavit. The Board denied De Beers' request by an Order dated December 5, 2007 and set the due date for De Beers' substantive response to the Summary Judgment Motion for January 4, 2008.

**B. The Parties**

**1. De Beers LV Ltd.**

De Beers LV Ltd. (which in October 2006 changed its name to DeBeers Diamond Jewellers Limited) is a United Kingdom company which traces its roots back to 1888 when diamonds were first mined by De Beers Consolidated Mines Limited.. *See* Declaration of Hamida Belkadi (hereinafter "Belkadi Decl.") at ¶ 3. For more than 100 years, De Beers has been the world's leading producer and wholesaler of diamonds. *Id.* at ¶ 4.

In 1939, De Beers commenced marketing and promoting diamonds in the United States. *Id.* at ¶ 4. In 1948, De Beers introduced its now famous "A Diamond is Forever" advertising campaign in the United States. *Id.* at ¶ 5. This advertising campaign and slogan have been instrumental in associating the notion of romance with diamonds. Since then, De Beers' advertising programs have been influential in the public's recognition of the diamond as a

symbol of love and commitment and therefore the ideal jewel for an engagement or wedding ring.

De Beers' "A Diamond is Forever" advertising campaigns have been immensely successful. *Id.* at ¶ 5. In fact, Advertising Age Magazine selected DeBeers' "A Diamond is Forever" campaign as No. 6 in its Top 100 advertising campaigns of the twentieth century and the slogan "A Diamond is Forever" was chosen as the number one advertising slogan of the twentieth century. *Id.*

In 2001, De Beers began making plans to enter the retail diamond and jewelry business. *Id.* at ¶ 6. In 2005, De Beers opened its first United States retail store on Fifth Avenue in New York City, which was soon followed by openings in Las Vegas, Beverly Hills, Houston and Washington D.C. *Id.*

## **2. De Boulle Diamond & Jewelry Company, Inc.**

De Boulle owns and operates a single-location, up-scale jewelry store in Dallas, Texas. *See* Saunders Decl. ¶ 4, Exhibit B. According to Opposer's web site, De Boulle markets and sells fine diamonds, jewelry and time pieces and is an authorized dealer of 17 luxury jewelry brands. *Id.*

## **III. ARGUMENT**

### **A. With Respect to the "DE BOULLE" and the "deB and Design" Marks, Summary Judgment Should Be Granted in Favor of De Beers.**

#### **1. The Applicable Legal Standards**

Summary judgment is an appropriate method of disposing of a case or a claim where there are no issues of material fact in dispute, leaving the case or claim to be resolved as a matter of law. Fed. R. Civ. P. 56(c). Here, no material facts are in dispute with regard to

Opposer's "DE BOULLE" and "deB and Design" marks and De Beers' marks, and therefore, summary judgment is appropriate.

The Board should grant De Beers' cross-motion for partial summary judgment because, upon an analysis of the relevant du Pont factors, there is no likelihood of confusion between the two registered De Boule marks and the five De Beers marks.

In making the determination of a likelihood of confusion, the Board applies the factors set out in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973):

1. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
2. The similarity or dissimilarity and nature of the goods or services as described in an application or registration in connection with which a prior mark is in use.
3. The similarity or dissimilarity of established, likely-to-continue trade channels.
4. The conditions under which and buyers to whom sales are made, i.e., "impulse" vs. careful, sophisticated purchasing.
5. The fame of the prior mark (sales, advertising, length of use).
6. The number and nature of similar marks in use on similar goods.
7. The nature and extent of any actual confusion.
8. The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.
9. The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark).
10. The market interface between applicant and the owner of a prior mark, i.e., whether the parties have previously entered into agreements that limit their rights to use the mark.
11. The extent to which the applicant has a right to exclude others from use of its mark on its goods.

12. The extent of potential confusion, i.e., whether de minimus or substantial.
13. Any other established fact probative of the effect of use.

*In re E.I. du Pont de Nemours*, 177 U.S.P.Q. at 567.

**2. The Parties' Marks are Entirely Distinct in Sight, Sound and Commercial Impression.**

This factor requires examination of “the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *In re E.I. du Pont de Nemours*, 177 USPQ at 567. Opposer’s marks “DE BOULLE” and “deB and Design” are entirely distinct in appearance, sound and commercial impression from De Beers’ trademarks “So DB”, “DB LOGO”, “DB MONOGRAM”, “DB SIGNATURE” and “DB STAR”. First, with respect to appearance, neither “DE BOULLE” nor the “deB and Design” marks resemble in the least any of De Beers’ trademarks. The name “DE BOULLE”, as well as the “deB and Design” mark (which consists of lower case letters “de” above a large capital “B” in a double lined, elongated octagon), are both entirely distinct in appearance from each of the five De Beers’ trademarks.

Similarly, with respect to sound, “DE BOULLE”, regardless of how it is pronounced, sounds entirely different from the marks “SO DB”, “DB LOGO”, “DB MONOGRAM”, “DB SIGNATURE” and “DB STAR”. In addition, De Boule, a French surname, conveys an entirely different commercial impression than the De Beers’ marks. The same can be said for the “deB and Design” mark, as the presentation of this design is dramatically different than the presentation of De Beers’ marks, thereby also conveying a distinct commercial impression.

In sum, it is plain to the eye and ear that the marks are entirely distinct.

**3. The Relevant Purchasers Are Discriminating and Exercise Extraordinary Care in Purchasing the Parties' Expensive Diamonds and Jewelry.**

There is no dispute between the parties that the goods involved in this proceeding include expensive diamonds and jewelry sold in very upscale retail establishments. Indeed, Mr. Boule describes his company's jewelry as "fine quality", "exclusive jewelry", "custom design[ed by] craftsmen". See Affidavit of Mr. Denis Boule (hereinafter "Boule Aff.") ¶ 6. Further, Mr. Boule states that he markets his company's diamonds and jewelry to affluent individuals and advertises its products in "luxury goods publications" such as *Millionaire Magazine*, *GQ Magazine*, *Robb Report* and others. *Id.* In addition, in Opposer's Motion for Summary Judgment, De Boule acknowledges that the relevant purchasers are sophisticated by stating that its jewelry is purchased by customers with "concern and knowledge of the value, grade, and quality of the actual goods." Opp. Mot. ¶ 42.

Under these circumstances, where there is no dispute that the goods are expensive and the purchasers are sophisticated and discriminating, there is no likelihood of confusion. See *Fortunoff Silver Sales, Inc. v. Norman Press, Inc.*, 225 USPQ 863, 869-870 (TTAB 1985) (finding no likelihood of confusion between the parties' respective marks because consumers of the parties' goods, namely, jewelry, were highly sophisticated and discriminating); *E.T.F. Enterprises, Inc. v. Nina Ricci, S.A.R.L.*, 213 USPQ 517, 525 (S.D.N.Y. 1981) (reversing the T.T.A.B.'s finding of a likelihood of confusion because the Board "apparently failed to consider the sophistication of the buyers" of the parties' expensive fashion products); *Fisher Stoves, Inc. v. All Nighter Store Works, Inc.*, 626 F.2d 193 (1st Cir. 1980) (placing a strong emphasis on the price of the goods in question and the highly sophisticated nature of the consumers in finding no likelihood of confusion).

As Professor McCarthy states in his treatise, “in making purchasing decisions regarding “expensive” goods, the reasonably prudent person standard is elevated to the standard of the “discriminating purchaser.” 3 McCarthy on Trademarks and Unfair Competition (3rd Ed.) § 23.96. Therefore, if the goods are expensive, the reasonably prudent buyer does not buy casually, but only after careful consideration. *Id.* In this context, confusion is less likely to occur. *Id.* Under the elevated discriminating purchaser standard applicable here, confusion between the parties’ respective marks is not likely to occur.”<sup>5</sup>

Indeed, it is difficult to imagine any type of good which is purchased by consumers with greater care than expensive diamonds. This, coupled with Opposer’s admission that its customers are knowledgeable and sophisticated, i.e., they purchase defendant’s goods with “concern and knowledge,” leads to the inescapable conclusion that confusion is not only unlikely, but is virtually impossible.

Further, the conditions under which the products are sold further support the notion that confusion is entirely unlikely. The Opposer’s goods are sold in a high-end single location retail store located in Dallas, Texas. Boule Aff. ¶¶ 6, 7. De Beers diamonds and jewelry are sold at its upscale, exclusive stores located in New York City, Beverly Hills, Las Vegas, Houston and Washington D.C. *See* Belkadi Decl. ¶ 6. Each of these stores is staffed by knowledgeable employees who are available to explain the origin and design of the diamonds and jewelry being sold and to answer any questions that potential customers may have regarding

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<sup>5</sup> Opposer cites one case for the proposition that “where the marks are identical, of course, sophistication as a factor in determining likelihood of confusion is less significant.” Opp. Mot. ¶ 40. Clearly, the marks involved here are not identical and therefore the Board should disregard this argument. Moreover, in the case cited by Opposer, *Source Services Corp. v. Source Telecomputing Corp.*, 635 F.Supp. 600, 230 USPQ 290 (N.D.Ill. 1986), the court noted that “where the cost of the defendant’s trademarked product is high, the courts assume that purchasers are likely to be more discriminating than they might otherwise be.” *Id.* at 294. Therefore, this case fully supports De Beers’ position that the elevated discriminating purchaser standard is applicable here.

the nature and source of the products. *Id.* at 7. Under these circumstances, there can be no likelihood of confusion.

**4. The Remaining du Pont Factors are Either Inapplicable or Do Not Impact the Likelihood of Confusion Analysis.**

The two foregoing du Pont factors, namely the similarity of the marks and the conditions under which sales are made/purchaser sophistication, are dispositive of the fact of, and legal conclusion, that there is no likelihood of confusion between Opposer's "DE BOULLE" and "deB and Design" marks on the one hand and De Beers' marks on the other. This is true notwithstanding that there is an overlap in the respective goods and channels of trade. The remaining du Pont factors are either inapplicable or neutral in the likelihood of confusion analysis.

For example, De Boulle has not demonstrated that its mark is "famous" within the meaning of the Lanham Act. A famous mark is one with extensive public recognition and renown. *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d 1303, 1305 (Fed Cir. 2002). The fame of a mark may be measured indirectly, among other things, "by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident." *Id.* Here, Opposer acknowledges that sales volume, advertising expenditures and length of use are the proper indicia used for determining whether a mark is famous, but provides no information pertaining to these criteria. *See* Opp. Mot. ¶¶ 44, 46. In fact, Mr. Boulle does not even claim that his trademarks are famous. Accordingly, there is no basis for the Board to find that the De Boulle marks are famous or even well-known among purchasers of diamonds and jewelry.

With regard to actual confusion, De Boulle has admitted that there has been none. See Response to Request for Admission No. 22; Saunders Decl. ¶ 5; Exhibit C. As De Beers has been selling its diamonds at retail stores in several locations for approximately 2 ½ years, there has been ample time for confusion to occur, but neither party is aware of even a single instance of actual confusion.

Therefore, for the reasons expressed above, the Board should grant summary judgment in favor of De Beers with respect to Opposer's "DE BOULLE" and "deB and Design" trademarks.

**B. With Respect to Opposer's Alleged "DB" Mark, There are Genuine Issues of Material Fact and Therefore, Summary Judgment Should Be Denied.**

**1. The Applicable Legal Standards.**

The party moving for summary judgment bears the initial burden of demonstrating, *prima facie*, the absence of any genuine issues of material fact, and that it is entitled to judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 1562, 4 USPQ2d 1793, 1795 (Fed. Cir. 1987); *University Book Store v. Board of Regents of the University of Wisconsin System*, 33 USPQ2d 1385, 1389 (TTAB 1994). A factual dispute is genuine, if, on the evidence of record, a reasonable finder of fact could resolve the matter in favor of the non-moving party. *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 850, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc. v. Roundy's Inc.*, 961 F.2d 200, 202, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992).

In addition, the evidence must be viewed in a light most favorable to the non-movant, and all justifiable inferences must be drawn in the non-movant's favor. *Lloyd's Food Products, Inc. v. Eli's Inc.*, 987 F.2d 766, 767, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993),



*Opryland USA*, 970 F.2d at 850; *Flatley v. Trump*, 11 USPQ2d 1284, 1287 (TTAB 1989).

Here, as demonstrated below, De Boule has not met its burden of demonstrating the absence of any genuine issues of material fact. On the contrary, there are bona fide issues regarding several material facts with respect to Opposer's alleged use of "DB" as a trademark, and therefore, summary judgment must be denied.

## **2. The Facts Surrounding Opposer's Claimed Adoption of "DB" Are in Question**

There are serious questions as to whether Opposer actually adopted "DB" as a trademark, whether it has ever used "DB" as a trademark, and whether "DB" is recognized by consumers and functions as a trademark. First, there are a number of inconsistencies and peculiarities with respect to Opposer's claims in this proceeding regarding the alleged "DB" mark. In particular, Opposer did not even mention the supposed "DB" mark in either the first or second Notices of Opposition filed in this proceeding, notwithstanding that the Notices were filed years after De Boule's alleged date of first use of the claimed mark. *See* Notice of Opposition (hereinafter "Not. of Opp.") re. "DB LOGO" and Not. of Opp. re. "DB MONOGRAM," Saunders Decl. ¶ 6, Exhibit D. Moreover, in Opposer's third Notice of Opposition, De Boule makes passing reference for the first time to a "DB" mark but does not allege a date of first use of the supposed mark. *See* Not. of Opp. Re. "DB SIGNATURE," Saunders Decl. ¶ 7, Exhibit E. It is only in the fourth and fifth Notices of Opposition that Opposer alleges a claimed date of first use of "DB". *See* Not. of Opp. re. "SO DB" and Not. of Opp. re. "DB STAR", ¶ 4, Saunders Decl. ¶ 8, Exhibit F.

Furthermore, Opposer did not file an application to register "DB" until April 7, 2005, after De Boule filed its third Notice of Opposition in this proceeding even though Opposer

filed applications to register its “DE BOULLE” and “deB and Design” trademarks on the same day, July 1, 2004. This begs the question, if Opposer had truly adopted and had been using “DB” as a trademark since December of 2000, why did it not mention the mark in its first two Notices of Opposition and why did it not apply to register the mark at the same time it applied for the “DE BOULLE” and “deB and Design” marks?

It is against this factual backdrop that the Board must view the evidence submitted by De Boulle. As shown below, when viewed in a light most favorable to De Beers, as the law requires, summary judgment must be denied.

**3. The Only Evidence Presented by De Boulle Regarding its Claimed “DB” Mark is Biased, Indefinite and Uncorroborated.**

The evidence submitted by Opposer in an attempt to demonstrate adoption and use of “DB” as a trademark raises more questions than it answers.<sup>6</sup> The only evidence submitted by Opposer on this issue is the Affidavit of Denis J. Boulle, the Chief Executive Officer and Chairman of the Board of Opposer. Mr. Boulle was also the former President of Opposer. Clearly, Mr. Boulle has a strong interest in the outcome of the proceeding and therefore his testimony should be given little or no weight. *See Jeffrey Milstein Inc. v. Gregor, Lawlor, Roth Inc.*, 33 USPQ2d 1684, 1687 (S.D.N.Y. 1994). In *Milstein*, the president of plaintiff testified at a preliminary injunction hearing that its trade dress had acquired secondary meaning in the marketplace. Even though plaintiff had previously submitted several newspaper articles as evidence in support of this argument, the court nevertheless accorded “little—if any—weight” to the president’s uncorroborated testimony because of his affiliation with plaintiff. *Id.*

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<sup>6</sup> Since the “DB” mark is not registered, De Boulle must demonstrate adoption and use of the claimed mark by competent evidence and, of course, De Boulle cannot rely on the alleged date of first use in the application. *See* 37 C.F.R. § 2.122(b)(2).

Further, the *Milstein* court emphasized that according little or no weight to biased, uncorroborated testimony is especially warranted when such testimony concerns “a central issue in the litigation on which that party bears the burden of persuasion.” *Id.* The same is true here. Mr. Boule is affiliated with Opposer and is therefore biased, his testimony is uncorroborated, and it concerns a central issue in the proceedings (alleged priority of use of the claimed “DB” mark). Accordingly, as in *Milstein*, Mr. Boule’s testimony should be accorded “little if any weight.” *See also, Re/Max International Inc. v. Help-U-Sell Inc.*, 20 USPQ2d 1945, 1946 (TTAB 1991) (“the testimony of interested parties is generally accorded little weight”); *R.J. Reynolds Tobacco Co. v. Brown & Williamson Tobacco Corp.*, 226 USPQ 169, 178 (TTAB 1985) (according little probative value to testimony evidence provided by an officer of the interested party); *Vitek Systems, Inc. v. Abbot Laboratories, Inc.*, 216 USPQ 476, 479-80 (8th Cir. 1982) (noting that the lower court “could refuse to credit the uncorroborated testimony of such interested” witnesses, who were seven of plaintiff’s employees or consultants).

Moreover, Mr. Boule’s Affidavit provides only scant, conclusory statements about Opposer’s alleged adoption and use of “DB” as a trademark. Mr. Boule states only that “De Boule designed the mark ‘DB’” “as part of the design of its Web site” and that “De Boule has used the DB mark *in association with* fine jewelry, diamonds, and timepieces sold to the general public...” Boule Aff. ¶ 8 (emphasis added). Mr. Boule also states in conclusory fashion that the “DB” mark is also contained on packaging; however, no corroborating evidence was submitted. *Id.*

Mr. Boule did not even attach examples of Opposer’s supposed use of the “DB” mark as exhibits to his Affidavit. Mr. Boule’s unsupported, uncorroborated and indefinite testimony cannot, as a matter of law, establish priority of use of “DB” as a trademark. *See*

*Central Mfg. Co. v. Paramount Parks, Inc.*, 2004 TTAB LEXIS 642, \*12-13 (TTAB 2004)

(holding that the oral testimony submitted by opposer was insufficient to establish priority of use because it was indefinite, lacking in specifics, and not supported by collaborating evidence).

In fact, the single piece of documentary evidence relied upon by Mr. Boulle was rejected by the Examining Attorney as a specimen of use. In support of his testimony regarding use of the “DB” mark, Mr. Boulle refers to the web site page submitted as a specimen of use in its trademark application to register “DB” (Appl. Serial No. 78/604,056). Boulle Aff. ¶ 8. However, the Examiner assigned to the “DB” trademark application issued an Office Action in which he stated that the web page for applicant’s web site “is unacceptable as evidence of actual trademark use because it does not show proper use of the mark with the identified goods.”<sup>7</sup>

Thus, Opposer has not presented any competent, much less corroborated, evidence on this Motion regarding the date of first use of “DB” as an alleged trademark. Significantly, De Boulle cannot rely upon the date of first use alleged in its trademark application to establish priority. *See* Trademark Rule § 2.122(b); *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1848 n.10 (TTAB 2004) (“the dates of use alleged in applicant’s applications are not evidence of such use, nor are the application specimens evidence on applicant’s behalf”). Accordingly, the only date of first use that Opposer may rely on with respect to the “DB” mark is the date of filing (i.e., April 7, 2005). *See ECI Division of E-Systems, Inc. v. Environmental Comms. Inc.*, 207 USPQ 443, 448 (TTAB 1980) (holding that “in the absence of *specific evidence* of applicant’s use of the mark sought to be registered, the

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<sup>7</sup> In response to the Office Action, De Boulle submitted another proposed specimen, a decal. But this too is insufficient to show trademark use because it does not show use of the mark in connection with the identified goods as set forth in the application. *See* TMEP § 904. This application is currently in suspension and therefore the Examining Attorney has not passed upon the propriety of the second specimen.

earliest use on which applicant can rely is the filing date of the application”) (emphasis added).

As the April 7, 2005 filing date is subsequent to the filing dates of each of De Beers’ five trademarks, summary judgment must be denied with respect to Opposer’s “DB” mark because there are genuine issues with respect to a central material fact in this consolidated proceeding-- the date of first use of “DB.”

Moreover, Mr. Boulle does not proffer any of the types of corroborating evidence that are critical to establishing trademark rights for an unregistered mark. For example, Mr. Boulle does not state or explain:

- 1) Who conceived of the alleged DB mark;
- 2) Who designed the DB mark (the DB mark, as allegedly used by Opposer is a design mark). *See* specimen submitted to PTO, attached as Exhibit G to the Saunders Decl. ¶ 9;
- 3) When the mark was first allegedly placed on product packaging or hangtags;
- 4) How the mark is actually allegedly used in connection with goods, e.g., on jewelry boxes, inner packaging, outer packaging, etc.;
- 5) Whether the “DB” mark has allegedly been used consistently and continuously on product packaging for all De Boulle diamond and jewelry products sold by De Boulle.

And perhaps most notably, Mr. Boulle did not submit any documents in an attempt to prove the date of first use of “DB,” such as, by way of example, invoices from jewelry box manufacturers or printers. These glaring omissions cast serious doubt as to De Boulle’s claims, which totally precludes summary judgment determination with respect to the DB mark.

Moreover, the documents produced by Opposer in response to De Beers’ discovery requests raise additional issues of material fact. The documents show that the registered “DE BOULLE” and “deB and Design” marks, consistent with bona fide trademark

use, are imprinted into jewelry boxes and packaging ribbons, whereas the claimed “DB” mark appears only to be a decal. *See* Saunders Decl. ¶ 10, Exhibit H.<sup>8</sup> Yet, Mr. Boulle makes no mention of a decal in his affidavit.

In sum, other than Mr. Boulle’s naked assertions, there is no evidence on De Boulle’s motion to prove use of “DB” as a trademark, and from the totality of the scant evidence presented, there are serious questions as to whether Opposer has ever made bona fide use of “DB” as a trademark much less as of the claimed date of first use. Clearly, this is a central, material issue of fact, which precludes the granting of De Boulle’s Motion for Summary Judgment.

**C. Mr. Boulle’s “Expert” Opinion Testimony Should be Stricken or Disregarded**

Mr. Boulle purports to be an “expert” witness, and in his affidavit, he offers opinion testimony on the ultimate issue of likelihood of confusion. Boulle Aff. ¶ 12-14. Mr. Boulle’s opinion testimony should be stricken or disregarded for two reasons: (1) Mr. Boulle is a biased witness; and (2) Mr. Boulle has not demonstrated that he is qualified to testify as an expert witness under the Federal Rules of Evidence.

The opinions set forth in Mr. Boulle’s affidavit are legal conclusions that only can be arrived at by neutral, unbiased individuals with specialized knowledge of trademark law, marketing, consumer behavior and related disciplines. First, neutrality is the cornerstone of any witness providing expert testimony. As discussed in Section C above, Mr. Boulle is the Chief

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<sup>8</sup> Because these documents were produced well after the close of the discovery period, De Beers was not able to question a De Boulle witness about them at a deposition.

Executive Officer and Chairman of the Board of Opposer, and therefore, has a strong interest in Opposer's success in this proceeding. Accordingly, Mr. Boulle is a biased witness.

Second, Mr. Boulle's claimed basis for his "expertise" is nothing more than the fact that he sells jewelry. Boulle Aff. ¶ 12. The fact that Mr. Boulle sells jewelry does not qualify him as an expert under F.R.E. 701. Further, Mr. Boulle has not proffered any specific information to qualify himself as an expert, such as the requisite "knowledge, skill, experience, training, or education." *See* F.R.E. 702.

Even if Mr. Boulle was qualified as an expert, he may only provide his opinion if "(1) the testimony is based upon sufficient facts or data, (2) the testimony is the product of reliable principles and methods, and (3) the witness has applied the principles and methods reliably to the facts of the case." F.R.E. 702. Mr. Boulle has not provided any evidence to suggest that his opinions are based on facts or data (e.g., survey evidence regarding consumer confusion of the subject marks). Accordingly, Mr. Boulle's opinion testimony should be stricken or disregarded.

#### **IV. CONCLUSION**

For the reasons expressed herein, it is respectfully submitted that De Beers' cross-motion for partial summary judgment should be granted, De Boulle's Motion for Summary Judgment should be denied in its entirety, and paragraphs 12-14 of the affidavit of Denis J. Boulle should be stricken.

Respectfully submitted,

DE BEERS DIAMOND  
JEWELLERS LIMITED  
(formerly DE BEERS LV LTD.)

Dated: January 4, 2008

By: \_\_\_\_\_

Darren W. Saunders  
Mark I. Peroff  
Vincent P. Rao II  
Kirkpatrick & Lockhart Preston Gates Ellis LLP  
599 Lexington Avenue  
New York, NY 10022-6030  
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*Attorneys for Applicant*



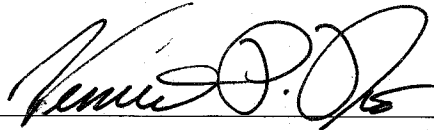
**CERTIFICATE OF SERVICE BY MAIL**

I hereby certify that on the 4th day of January, 2008, I served a true and correct copy of the foregoing Applicant's Cross-Motion for Partial Summary Judgment and Response in Opposition to Opposer's Motion for Summary Judgment on the attorneys for the Opposer at the addresses indicated below, by depositing said document in the United States mail, first-class postage prepaid:

Scott T. Griggs, Esq.  
Griggs Bergen LLP  
Bank of America Plaza  
901 Main Street  
Suite 6300  
Dallas, Texas 75202

Pieter J. Tredoux, Esq.  
300 Park Avenue, Suite 1700  
New York, N.Y. 10022

Dated: January 4, 2008

A handwritten signature in black ink, appearing to read "Vincent P. Rao II", is written over a horizontal line.

Vincent P. Rao II

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

De Boulle Diamond & Jewelry, Inc.	:	
	:	
Opposer,	:	Consolidated Opposition No.: 91162370
	:	Opposition Nos. 91162370
v.	:	91162469
	:	91164615
De Beers LV Ltd.	:	91165285
	:	91165465
Applicant.	:	
	:	

DECLARATION OF HAMIDA BELKADI

I, Hamida Belkadi, hereby declare:

1. I make this Declaration in support of De Beers LV Ltd.'s (which in October 2006 changed its name to De Beers Diamond Jewellers Limited) Cross-Motion for Partial Summary Judgment and Response in Opposition to Opposer's Motion for Summary Judgment. I have personal knowledge of the facts stated herein except as to certain background matters, as to which I have gained knowledge through my employment and job responsibilities. If called as a witness, I could and would testify competently to all facts within my personal knowledge.

2. I am the Chief Operating Officer of De Beers Diamond Jewellers U.S. Inc., ("DBDJ") located at 20 West 55<sup>th</sup> Street, 7<sup>th</sup> Floor, New York, New York 10019. DBDJ is a wholly-owned subsidiary of De Beers Diamond Jewellers Limited, a U.K. incorporated joint venture between the diamond mining company De Beers S.A. and the French luxury goods company LVMH - Moët Hennessy Louis Vuitton. I am responsible for overseeing all aspects of DBDJ's business operations in the United States, including the selection and training of staff

members, opening new retail store locations, store merchandizing and developing advertising and marketing strategies for the United States market.

3. De Beers S.A. and the De Beers Group of companies (together “De Beers”) is a consortium of diamond mining and marketing companies which trace their origins back to 1888, when diamonds were first mined in South Africa by De Beers Consolidated Mines Limited.

4. For more than one century, De Beers has been the world’s leading producer and wholesaler of rough diamonds. In 1939 De Beers began to market and promote diamonds in the United States.

5. In 1948, De Beers commenced its “A Diamond is Forever” advertising campaign in the United States, which has been instrumental in associating the notion of romance with diamonds. Since then, De Beers’ advertising programs have been influential in the public’s recognition of the diamond as a symbol of love and commitment and therefore the ideal jewel for an engagement or wedding ring. De Beers’ “A Diamond is Forever” advertising campaigns have been immensely successful. In fact, Advertising Age Magazine selected DeBeers’ “A Diamond is Forever” campaign as No. 6 in its Top 100 advertising campaigns of the twentieth century and the slogan “A Diamond is Forever” was chosen as the number one advertising slogan of the twentieth century. Attached as Exhibit A are copies of early advertising featuring “A Diamond is Forever” published in the United States.

6. In 2001, so that it could combine both parties’ skills with the De Beers’ brand and enter into a retail diamond and jewelry business in the United States and worldwide, De Beers decided to form the joint venture now known as De Beers Diamond Jewellers Limited with LVMH. In June 2005, De Beers Diamond Jewellers Limited, and specifically, DBDJ, opened its

first De Beers retail store in the United States on Fifth Avenue in New York City. DBDJ opened additional De Beers retail stores in Los Angeles in December 2005, in Las Vegas in January 2007, in Houston in September 2007 and in Washington D.C. in November 2007. All of these stores are located in very exclusive areas. For example, the Los Angeles store is located in Beverly Hills on Rodeo Drive and the Las Vegas store is located in the Caesar's Palace Hotel. Each of the De Beers retail stores is, in every aspect, a high-end, upscale retail environment.

7. De Beers' diamond jewelry is sold only in its exclusive retail stores and on its website. The employees at each store receive special training and are knowledgeable about the origin and design of the diamond jewelry being sold. These employees are available to explain to customers details about De Beers' jewelry and to answer any questions that the customers may have regarding the design, production and source of De Beers diamond jewelry.

8. I am personally involved in media planning and advertising placement for the United States. Currently, DBDJ advertises in national magazines and newspapers, local magazines and newspapers, and other media such as radio in select markets.

9. The De Beers name and trademarks have an excellent reputation in the United States and worldwide. De Beers symbolizes a producer and designer of the world's finest diamond jewelry. De Beers retail stores, as well as De Beers Diamond Jewellers Limited and DBDJ's lines of jewelry products have received extremely favorable press in the United States and the De Beers' brand is highly regarded among purchasers of fine diamond jewelry. Attached as Exhibit B are some representative samples of press articles published in the United States.

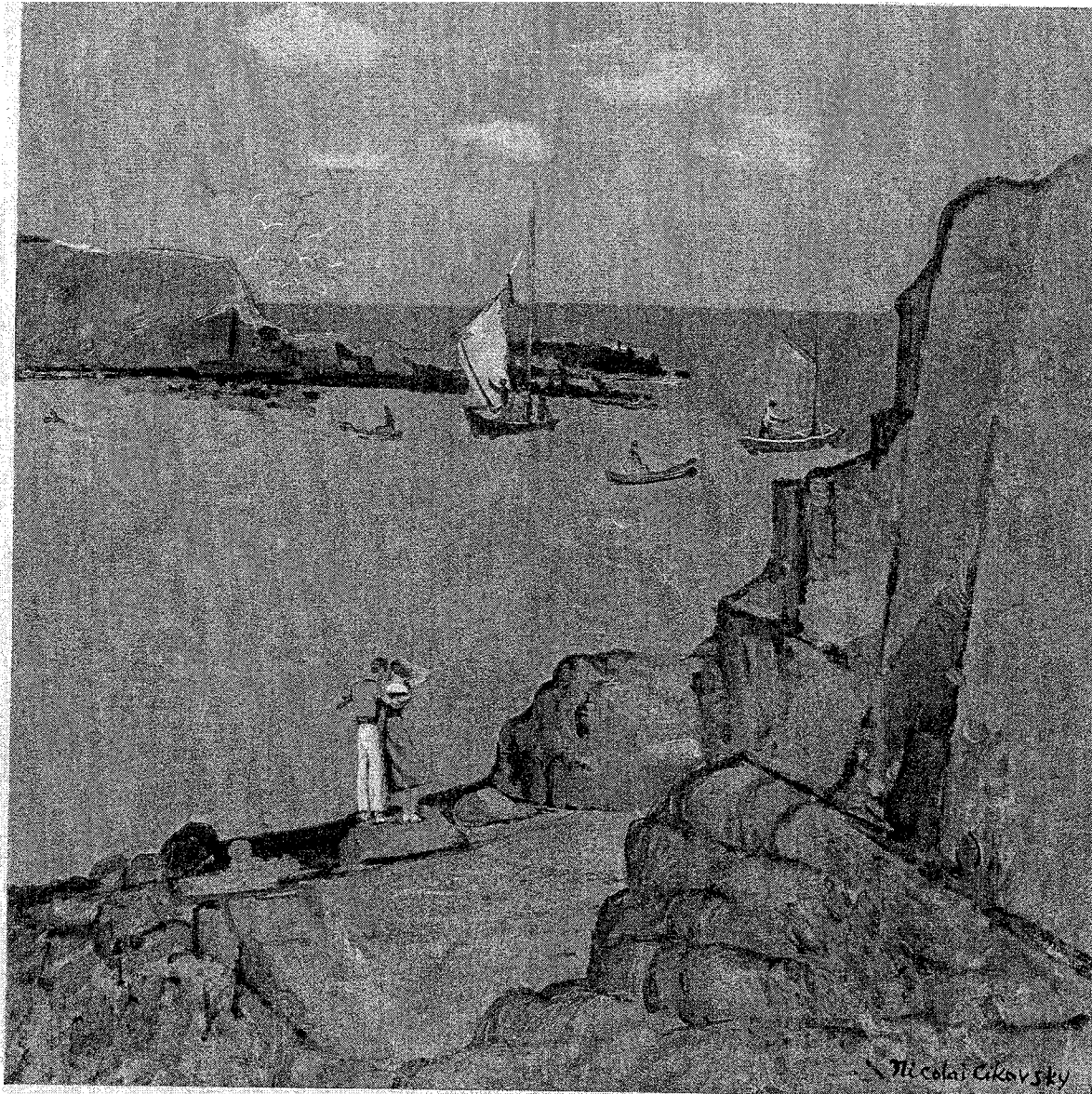
I declare under the penalty of perjury that the foregoing is true and correct. Executed on

January 4, 2008.

New York, New York

H. Belkadi  
Hamida Belkadi

## **EXHIBIT A**



HONEYMOON ON THE ROCKY COAST OF MAINE...  
where sea and sun bid welcome. Painted for  
the De Beers Collection by Nicolai Cikovsky.

## a Diamond is forever

One-quarter carat  
40 points  
\$80 to \$195



One-half carat  
80 points  
\$200 to \$440



One carat  
100 points  
\$460 to \$1050



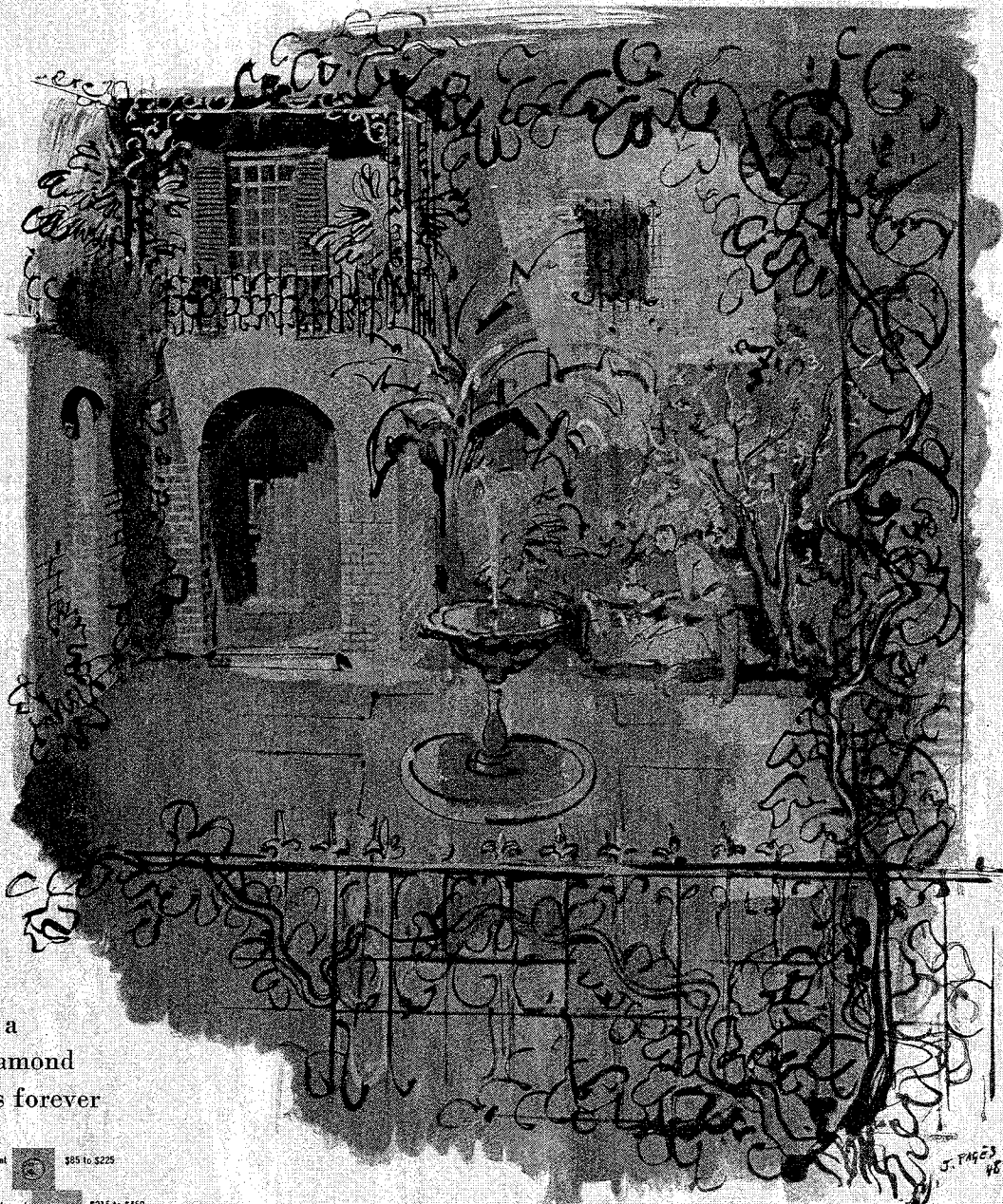
Two carats  
200 points  
\$1000 to \$2000

The price ranges at left were developed for your guidance through a nationwide independent check among representative jewelers in April, 1949. (Exact weights shown are infrequent.) Add Federal tax.

**T**ogether, hearts light with love, they've shared their new life's happiness . . . the church so full of music and of friends, the wedding banquet marked with cake and laughter, and now, these touched-with-magic days in a world that seems their own. In the engagement diamond on her finger, a fire is kindled by such joys, to light their way through future days with hopes and memories. That is why her diamond, though it need not be costly or of many carats, should be chosen with special care. Color, cutting and clarity, as well as carat weight, contribute to its beauty and value. A trusted jeweler is your best adviser.

De Beers Consolidated Mines, Ltd.

H. W. AYER & SON



a  
Diamond  
is forever

One-quarter carat 25 POINTS	\$85 to \$225
One-half carat 50 POINTS	\$215 to \$450
One carat 100 POINTS	\$555 to \$1050
Two carats 200 POINTS	\$1355 to \$3180

The above price ranges were developed for your guidance through a nationwide survey among representative jewelers in January, 1949. (Exact weights shown are infrequent.) Add Federal tax.

H. W. HYER & SON

HONEYMOON IN NEW ORLEANS . . . a city rich in ante-bellum landmarks, southern traditions and old French provincial flavor. Painted for the De Beers Collection by Jean Pages.

There's been magic in each passing moment of their new lives . . . in the stirring silence as he waited at the altar steps . . . in the gay laughter as she tossed her bride's bouquet . . . and now, in the quiet beauty of the days they share in love. Such things the heart remembers . . . such things a diamond can recall forever, in lights that grow more bright with meaning through the years. That is why her engagement diamond should be worthy of pride. Her diamond need not be costly, or of many carats, but it should be chosen with care. Color, cutting and clarity, as well as carat weight, contribute to its beauty and value. A trusted jeweler is your best adviser.

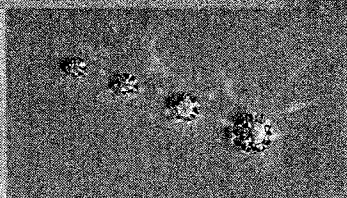
De Beers Consolidated Mines, Ltd.

1949





*Pastoral Honeymoon* — painted for the De Beers Collection by Jean Hugo



1/4 carat (25 points) \$85 to \$105  
 1/2 carat (50 points) \$220 to \$475  
 1 carat (100 points) \$625 to \$1250  
 2 carats (200 points) \$1395 to \$3500

The above prices were secured for your guidance through a nationwide check in January, 1950. They are for the top-quality stones generally offered by jewelers for engagement rings. Exceptionally fine stones are, of course, more expensive. (Exact weights shown are infrequent.) Add Federal tax.

**WHEN CHOOSING YOUR ENGAGEMENT STONE** . . . remember color, cutting, and clarity, as well as carat weight, contribute to a diamond's beauty and value. It is important to seek the counsel of a trusted jeweler. He will help you find the size and quality and style of stone that is in keeping with your preferences, and what you wish to spend.

*a Diamond is forever*

May your happiness  
 last as long as your diamond

Ceaseless as the winging air, your engagement diamond shines  
 in joy. In its deep pools of lovely light, the memory of little  
 pleasures . . . the sound of a whispered word of love . . . the touch  
 of a gentle hand . . . the sight of a tender smile . . . will be  
 treasured ever. Your diamond, though it may be modest in cost,  
 should be chosen with care, for nothing else on earth can take its place.

De Beers Consolidated Mines, Ltd.

H. W. ATOR & SON



Honeymoon by the Bay . . . painted for the De Beers Collection by Jean Hugo

## May your happiness last as long as your diamond

*As shimmering water mirrors the brightness in the day, your gleaming engagement diamond reflects the happiness in your heart. This fair token of love declares your hopes and dreams, and holds them close through all the years for constant recollection. That is why your diamond seems to grow in loveliness. Your diamond, though it may be modest in cost, should be chosen with care, for nothing else on earth can take its place.*

### a Diamond is forever



1/4 carat (25 points) \$85 to \$200  
 1/2 carat (50 points) \$230 to \$460  
 1 carat (100 points) \$590 to \$1165  
 2 carats (200 points) \$1215 to \$3125

The prices shown were secured for your guidance through a nationwide check in October, 1950. Jewelers were asked for the prices of their top-grade engagement ring diamonds in the weights indicated. The result is a range of prices, varying according to the qualities offered by different jewelers. Exceptionally fine diamonds are, of course, higher priced. (Exact weights shown are infrequent.) Add Federal tax.

When choosing your engagement stone . . . remember color, cutting, and clarity, as well as carat weight, contribute to a diamond's beauty and value. It is important to seek the counsel of a trusted jeweler. He will help you find the size and quality and style of stone that is in keeping with your preferences, and what you wish to spend.

De Beers Consolidated Mines, Ltd.

## **EXHIBIT B**



## JEWELRY

A relative newcomer to the diamond retailing business puts its fourth U.S. location in Houston

# De Beers sees gold in city

By DAVID KAPLAN  
HOUSTON CHRONICLE

“**T**HIS is our big guy in the store right now,” said Lindsay Curington, brand ambassador at the De Beers in the Galleria.

She was referring to a 21.8 carat “fancy yellow” diamond ring.

That big guy can be yours for a little more than \$1 million. Wait a while, and you’ll be able to spend a lot more on rings and other things.

The retailer whose parent

company made the phrase “A diamond is forever” famous plans to offer pieces costing more than \$20 million.

In town about a month, De Beers Diamond Jewellers chose Houston as its fourth location in North America, joining such high-profile luxury jewelry chains as Cartier and Tiffany & Co. in the city.

Other De Beers are in New York City, Beverly Hills and Las Vegas.

“Houston was a natural choice because it’s the fourth-largest city in the U.S., and the Galleria is the fourth-largest mall in America,” said

Please see **DE BEERS**, Page D4



MAYRA BELTRÁN PHOTOS: CHRONICLE

**DRIPPING WITH DIAMONDS:** De Beers sales representatives Mary King and Jaydn Bui look for the serial number of the Wildflower necklace, an \$85,000 piece containing 1,613 diamonds, at the Galleria store.



**NEW TENANT:** A Galleria shopper passes by the new De Beers store, the fourth retail location in the U.S. for the global diamond powerhouse.



**TEST DRIVE:** De Beers sales representative Jaydn Bui, left, speaks to customer Angela Pham as she tries on the \$1 million "fancy yellow" diamond ring. The store plans to offer pieces valued at more than \$20 million. MAYRA BELTRÁN: CHRONICLE

## DE BEERS: Jewelry retailer looks to cash in on the high end

### CONTINUED FROM PAGE D1

Hamida Belkadi, chief operating officer of De Beers Diamond Jewellers.

The jeweler is scheduled to open stores in Washington, D.C., and San Francisco before the year ends. Altogether, De Beers has 23 stores worldwide.

### Newcomer to retailing

Though De Beers has been mining and selecting diamonds since 1888, it's only been in the retail business for six years.

And according to one analyst, it is getting in at the right time.

"With the explosion of the luxury retail sector, jewelers at the top end are reporting tremendous numbers," said Howard Davidowitz, chairman of Davidowitz & Associates, a national retail consulting and investing banking firm in New York City.

He noted that retailers in the upscale market like Neiman Marcus and Saks Fifth Ave. are also selling more and more very high-end jewelry.

The luxury market is "far from peaking," Bear Stearns analyst Taposh Bari, who follows publicly traded Tiffany & Co., said in a report.

De Beers also was wise to open its Houston store in the fall, giving itself time to prepare for the Christmas

*"When people spend hundreds of thousands of dollars on diamonds, the level of perfection of the stone is of tremendous importance, and De Beers' reputation for quality is a big advantage."*

—HOWARD DAVIDOWITZ  
retail analyst

season, Davidowitz said.

While most retailers do 20 to 22 percent of their annual business in November and December, jewelers take in 30 to 35 percent of their revenue in those months, he said.

### Building a brand

For its retail stores, De Beers Diamond Jewellers, which is jointly owned by De Beers SA and LVMH Moët Hennessy Louis Vuitton, is pushing the notions of quality, credibility and security.

An in-store "Beauty Scan" machine provides customers with magnified views of each facet of a stone. And each jewelry item sold comes with a passport and a hidden mark

identifying the gem.

"When people spend hundreds of thousands of dollars on diamonds, the level of perfection of the stone is of tremendous importance, and De Beers' reputation for quality is a big advantage," Davidowitz said.

One of De Beers' more popular lines, Talisman, features a mosaic of polished and unpolished diamonds in different shapes and colors. The least expensive item in the store earlier this week was a \$550 Talisman pendant.

Since opening, the Houston De Beers store has displayed a \$3.7 million necklace from the Marie Antoinette line.

### The 'forever' slogan

The marketing campaigns of its parent company, De Beers SA, are legendary.

In 1947, a copywriter working on the De Beers account at the agency NW Ayer coined the slogan: "A diamond is forever."

NW Ayer also was able to hire Picasso and Dali to produce art as part of a De Beers advertising campaign, and got Hollywood directors and screenwriters to include scenes that captured the allure of diamonds.

david.kaplan@chron.com

# Charitable Carats

De Beers' Ballet Ball auction prize:  
Wildflower necklace  
composed of 208 diamonds  
set in white gold



## Balletomanes and Symphony Supporters Turn Out for De Beers' Gem-borees

BY CATHERINE D. ANSPON. PHOTOGRAPHY FULTON DAVENPORT.

### Sparkle Plenty

When De Beers — the international jeweler that invented diamonds' 4Cs — opened their first-ever Texas boutique in the Houston Galleria (and fourth U.S. store), you can bet our social gems attended. And to properly launch the luxe bauble stop, not one, but two evenings would do. So De Beers paired with the Houston Ballet for an opening night at the home of connected, philanthropic couple **Karen and Mike Mayell**. This divine, diamond-studded dinner was succeeded the following eve by a bash store-side saluting the Houston Symphony.



### De Beers' Danse Fever

The elegant Mayells performed as perfect hosts for a Jackson and Company-catered dinner party in honor of next February's Ballet Ball, romantically themed "Glamorous Gershwin." De Beers dignitaries traveled from far and wide to attend (and stay on for store festivities the following day), including London-based Worldwide CEO **Guy Leymarie**, joining Manhattan colleagues **Selda Bensusan**, **Dirk Gruytters**, **Hamida Belkadi**, and **Erin O'Mahoney**, as well as Houston-based store manager **Bridgette Bottone**. Stunners

ogling the De Beers diamonds on display: Ballet Ball 2008 chair couple **Phoebe and Bobby Tudor**, auction chair duo **Ceron and Mary Beth Aspromonte**, who, like the chair couple, have been conspiring for months on the black-tie fête. **Sheridan and John Eddie Williams**; **Ann and Mathew Wolf**, Houston Ballet main man **C.C. Conner**; **Terry Wayne Jones**, **Mark Sullivan**; **Terrie and Mike Turner**; **Melissa and Michael Mithoff**; **Kris and Richard McGee**; **Denise and Philip Bahr**; **Molly and Jim Crowmover**;

**Martha and Richard Finger**, and **Dancie and Jim Ware**.

**Sparkling moments:** While Gershwin tunes tinkled on the piano, guests savored a signature Jackson touch: desserts shaped like De Beers gift boxes. Another highlight was the vigorous voting on De Beers' donation for the Ballet Ball silent auction. Garnering the most nods: the graceful Wildflower necklace, 208 diamonds set in white gold, weighing in at 2.06 carats. Stay tuned for its Ballet Ball debut February 16, 2008.



John and Sheridan Williams

### Noteworthy Nocturne

It was a rhapsody in diamonds when De Beers tossed open its doors for the first time, with a notable night honoring Houston Symphony supporters. The soirée saluted 2007 - 2008 event chairmen, including Symphony Ball chair quartet **Mary Ann and David McKeithan** and **Julia and Russell Frankel** (save the date for "Moonlight, Magnolias and Martinis," March 7, 2008); this fall's opening night chairmen **Frank Fawcett Peterson** and **Philip Peterson** joined by co-chairmen **Linda and Gene Dewhurst** and **Maureen Boyd Tashnek** and **Warren Tashnek**; Pops chair foursome **Joyce Echols**, **Tena Lundquist Faust**, **Elizabeth Petersen**, and **Susan Plank**; next month's Magical Musical Morning terrific trio **Liz Glanville**, **Nancy Littlejohn**, and **Gretchen McFarland**; and **Charlotte Rothwell**, set to chair the Maestro Wine Dinner in May '08. Other well-orchestrated guests: glam gal pals **Harriet Gertner** and **Patricia Harrison**, **Michael Parmet**, newlywed **Donna Spear**, **Margaret Williams** with **Jim Daniel**, **Omara and Sam Abraham**, **Susan and Dick Hansen**, **Lori Sorock**, **Susanna Brundrett**, and **Bob Sakowitz**. How's that for some serious social bling?



POLO NET RISES/5 NRDC SAID TO EYE PETER SOM/5

Women's Wear Daily • The Retailers' Daily Newspaper • February 8, 2007 • \$2.00

Inside:  
pg. 28  
The WWD List  
Best-known Live Jewelry Brands

# THURSDAY

Sportswear

## The Power Flapper

NEW YORK — Introducing the new hybrid — an Eighties take on the Twenties that Lazaro Hernandez and Jack McCollough turned into high-octane fashion at Proenza Schouler on Wednesday. Their collection was full of polished sophistication and major decorations, as in this sturdy wool felt coat embroidered with crystals. For more, see pages 8 to 15.

## An Overheated System: Frenzied Fashion Seasons Propel Debate on Change

By Marc Karimzadeh

**I**t's day seven into the fall season, with a grueling month of fashion shows still to come.

And as buyers, press and clients sit through stream after stream of clothes, suffer the crush of paparazzi and wait for yet another late-running celebrity to pose for her flashbulb moment, many are asking the same question: Is the entire system *démodé*?

The list of frustrations with the status quo has been growing for the last few seasons. Some complain the individual fashion weeks go on too long, and there are those, like Prada's Patrizio

See **System**, Page 16

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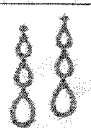


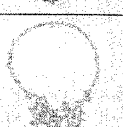
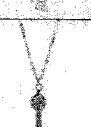
# TheWWDList

## The Finest Jewels

The top 12 most familiar jewelry brands ranked by luxury consumers.

The red carpet is intended to boost a luxury brand's image, but there are other ways to raise a profile, including store and brand expansion, compelling marketing and adorning models with collection pieces. So which jewelry brands rank highest when it comes to luxury consumer awareness? In January, the New York-based Luxury Institute released a study on which luxury jewelry brands were most familiar. The institute surveyed more than 500 respondents, ages 30 and above, with a household net worth of \$5 million or higher. Below, the top 12 brands and what wealthy consumers think of them.

— Cecily Hall, with contributions from Sophia Chabbott

1		<b>TIFFANY</b> Luxury consumers who are familiar with this brand: 80.2 percent "It's amazing how resilient this brand is," said Milton Pedraza, chief executive officer of the Luxury Institute. "Tiffany delivers great value to wealthy consumers, and it consistently ranks highly in terms of uniqueness and exclusivity, even though it's considered more of a ubiquitous brand." The latest news for Tiffany & Co.: a new store opening on Wall Street in the fall. Speaking of Wall Street, the stock is up 12 percent in the last year. Michael J. Kowalski, chairman and CEO, said of the holiday period, "We saw healthy sales increases in categories ranging from diamonds to silver jewelry."
2		<b>CARTIER</b> 77 percent At the Golden Globe Awards in January, Sienna Miller wore diamond chandelier earrings from Cartier. Cameron Diaz was adorned in more than \$150,000 worth of rings alone at the People's Choice Awards last month, according to people.com: five large cocktail rings, along with two bracelets (valued at close to \$80,000), which works out to an estimated total of \$230,000 in Cartier diamonds. The Paris-based jeweler recently reopened its store in Short Hills mall in New Jersey, an event that was quite the to-do when Mandy Moore stopped by to cohost the holiday celebration.
3		<b>DE BEERS</b> 60.5 percent Famous for the slogan, "A Diamond Is Forever," De Beers, the world's preeminent diamond-mining company, was established in 1888. The company, now as a brand, has picked up some impressive endorsements on the red carpet, including one from Scarlett Johansson. The actress wore a 30-carat diamond cluster necklace to the Oscars in 2004. Joely Richardson also appeared in De Beers diamonds for the 2003 BAFTA Awards in London. One study respondent noted, "De Beers has the best quality and is consistent and knowledgeable with its diamonds."
4		<b>GUCCI</b> 59.1 percent It's likely that most memorable Gucci moments on the red carpet have included shoes or apparel, because the luxury brand just launched its fine jewelry collection last year. "This is a halo effect we see with Gucci," Pedraza said. "This is such a luxurious and trusted brand, so when it expands into areas such as fine jewelry, it will still maintain that high-end cachet, and awareness will continue to increase." Some of the latest pieces in its collection include the 18-karat white gold Horsebit ring and the sterling silver Cord bracelet with oval chain detail.
5		<b>BULGARI</b> 51.7 percent In April, Bulgari will unveil a refurbished flagship in New York. The new design will place all women's jewelry and watches on the ground floor. The company has recorded impressive sales gains, as well: WWD reported in November that Bulgari's third-quarter revenue from jewelry rose 7.7 percent to 92.5 million euros, or \$118.4 million. The red carpet has witnessed Bulgari on Hollywood stars such as Keira Knightley, who wore a Bulgari necklace to the 2006 Oscars, and Chloë Sevigny and Jennifer Garner, who both appeared in Bulgari jewels at the 2007 Golden Globes.
6		<b>VAN CLEEF &amp; ARPELS</b> 50.1 percent This brand celebrated its 100th anniversary last year with a soiree in Paris at the famed Tuileries Gardens. The jewelry house also commissioned Randall A. Ridless to redesign its landmark boutique on Fifth Avenue. More recently, the brand has been spotted at awards ceremonies, such as the Golden Globes last month, when Reese Witherspoon appeared in Van Cleef & Arpels' diamond bracelet and earrings, as did Maggie Gyllenhaal, who dazzled in a collection of bracelets, along with the house's 1923 Pampilles earrings with sapphires and baguette-cut diamonds.
7		<b>HARRY WINSTON</b> 48.3 percent It's the end of an era for this Fifth Avenue jeweler. WWD reported in September that Aber Diamond Corp., a Canadian diamond mining company, has acquired the jeweler's remaining minority interest for \$157 million. "For the first time in 74 years, there will not be a Winston family member at the helm of the company that has a legacy of creating some of the most expensive diamond jewelry in the world," WWD said. The brand has been a red-carpet staple for stars such as Gwyneth Paltrow and Jennifer Garner, but is facing strong competition from others in the top 12.
8		<b>CHANEL</b> 47.3 percent Chanel's fine jewelry features the Coco collection — inspired by Venetian and Byzantine gilding and stonemasonry — and Privee, which is entirely dedicated to diamond pieces, among others. Red-carpet representatives for the French jeweler include Salma Hayek, who this year appeared at the Golden Globes adorned in a diamond right-hand ring and earrings from Chanel. Though Rinko Kikuchi of "Babel" showed up in a poufy Chanel dress that raised an eyebrow or two, her Chanel diamond ring was a stunner.
9		<b>DIOR</b> 47.1 percent In October, Dior president Sidney Toledano told WWD in Moscow, "Luxury is really booming." He was referring to fur, diamond jewelry and high-end bag sales at Dior's latest high-profile flagship opening in Moscow. Regarding the flagship, WWD said, "Fine jewelry by Victoire de Castellane is in an adjacent room that reflects the whimsical interior of the Dior jewelry unit on Paris' Place Vendôme, with its pearl-gray walls, panther prints and baubles displayed on tiny chairs."
10		<b>MIKIMOTO</b> 44 percent Known for its collection of quality cultured pearls, this brand was founded in 1893 by Kokichi Mikimoto, who is quoted on the company Web site as having said, "I would like to adorn the necks of all the women of the world with pearls." Many respondents noted satisfaction with the overall quality. A loyal consumer said, "These are timeless, classic products that are understatedly elegant and not flashy." Mikimoto's latest ad campaign, featuring model Mia Rosing, combines "glamorous tradition with a playful, sexy, art-deco appeal," according to its Web site.
11		<b>PIAGET</b> 42.6 percent On the 2006 Emmy Awards red carpet, Eva Longoria was radiant in Piaget's Waterfall Motif earrings in white gold with 68 diamonds. She was also sporting Piaget's Cascade Manchette bracelet in white gold with 329 brilliant-cut diamonds. Standout items in its collection include the 18-karat white gold Possession ring, which is really two bands linked by 480 diamonds, and its heart-shaped bracelet in 18-karat white gold, consisting of 402 diamonds. The fine jewelry and watch brand is owned by Compagnie Financière Richemont SA.
12		<b>DAVID YURMAN</b> 36.3 percent Busy, busy, busy: This describes the New York-based brand's schedule. With a new CEO, Paul Blum, David Yurman has made significant advances, including the move to higher-end jewelry and its first fragrance launch with Groupe Clarins. In January, the firm opened on Rodeo Drive with a 1,000-square-foot flagship. WWD reported that it features "Yurman's broadening collection, ranging from sterling silver signature pieces to platinum, to a diamond bridal collection to one-off pieces made from the designer's personal collection of vintage and rare gemstones."



LOS ANGELES

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## PHILIP SEYMOUR HOFFMAN

TAKES HOLLYWOOD BY STORM IN *CAPOTE*

**50** PAGES  
OF FASHION  
& STYLE



# Jammin' until the Break of Dawn

So much to do, so little time. BY REBECCA BLOOM



IF THERE IS ONE THING I KNOW, it is that this town does not sleep. Sure, New York has a Sinatra song praising its night-owl tendencies, but we can certainly give Frank a run for his money. L.A. just sleeps differently. We eat at seven, finish drinks by 10, close the bars by two, and get up at dawn with our dogs to hit the trails. We opt for full days and full nights.

And if there is one thing that I adore doing, it's window shopping for the decadent baubles I dream will grace me in that other life I plan on living: the one where I go to balls, dressed in couture, eating caviar with princes. And there's no better spot than the new De Beers store on Rodeo Drive to spark my fancy. At one of three lovely events held in celebration of its opening, **Guy Leymarie**, **Alyce Alston**, and De Beers Ambassador **Neil Lane** honored *The Hollywood Reporter's* Women in Entertainment: Power 100 with the help of host **Sherry Lansing**. With the Gift to Give program, where 10 percent of all De Beers sales in December was donated to various charities including AmfAR and Project Angel Food, the company made its strong philanthropic side known in Beverly Hills in a truly classy way. Diamonds and good deeds—a sparkling combination.

More gems were on display in the fabulous penthouse suite of the Chateau Marmont. Jeweler **Stephen Webster** and **Christina Aguilera** fêted **Corbin Bernsen**, **Amanda Pays**, **Todd Traina**, **Nicole Paggi**, and *Grey's Anatomy's* **Kate Walsh** for an evening of Champagne and jewelry celebrating Webster's *Femme Fatale* collection. Inspired by the sirens of the 1940s, the jewels are a mix

of classic glamour and Webster's flair for edgy rock 'n' roll. My favorite, the corset earrings with web-cut diamonds, could easily glide down any red carpet or fall into step backstage at a Rolling Stones concert.

Another Brit hit L.A. and charmed shoppers with his gentlemanly nature and affable personality. Paul Smith's new cotton-candy boutique, stocked to the gills with his quirky clothes, unique gifts, and clever accessories, drew an eclectic crowd of this town's most fashionable folks. **Ed Ruscha**, **Joy Bryant**, **Rachel Zoe**, **Steve Jones**, **Henry Duarte**, and **Tarina Tarantino**, to name a few, wandered amid Smith's classics, including his crisp tailored shirts with all those playful details he is known for, and for which I will always remember a handsomely tattooed ex with a penchant for French cuffs.

**Alex Balahoutis** relaunched her *Strange Invisible Perfumes* in a manner that confirmed her attention to detail and all things chic. The new boutique is inviting and warm, and ridiculously stylish. If only I could put my house together in the same way! Her mother **Linda Bruckheimer**, **Jim Berkus**, **Pat Riley**, and **Marg Helgenberger** mingled among the signature scents and went home with something special made just for the evening: *Strange Invisible Perfumes' Antony & Cleopatra*. With night-blooming jasmine and Persian lime, the fragrance reflects the tender side of the passionate, albeit tragic, love story. I feel lucky that a small touch of Balahoutis's inventive charm and unique nose is now sitting on my vanity.

And this year, the Grammy Jam, presented by the Recording Academy, Entertainment

Industry Foundation, and Mercedes-Benz USA and celebrating the legacy of **Stevie Wonder**, was a smash hit. Guests such as **Susan** and **Jon Dolgen**, Recording Academy President **Neil Portnow**, **Angie Harmon**, **Jason Sehorn**, and **Jamie Tisch** joined musicians **Eric Benét**, **George Benson**, **George Clinton**, **Herbie Hancock**, **Hootie & The Blowfish**, **India.Arie**, **Keb' Mo'**, **Josh Kelley**, **Mary Mary**, and **Angie Stone** to honor the 22-time Grammy Award winner. **Jamie Foxx** lit up the stage with an impromptu jam, and all were on their feet for hours, reveling in Wonder's classic tunes. Proceeds from this night of song benefited the Grammy Foundation, InnerSpark/California State Summer School for the Arts, For the Arts, Inner-City Arts, and the Museum of Contemporary Art.

Lastly, here are two L.A. ladies whom I am sure we will be hearing more about: **Jillian Kogan** who, inspired by Jasper Johns' genius at turning the ordinary into the extraordinary, reinterprets the iconic California flag by incorporating Pop Art elements into the familiar image. Although she just closed her successful show at Modern One Gallery, you can check out her website, [jilliankogan.com](http://jilliankogan.com). And **Rachel Bailit**, whose play, *Sugar Happens: A One-Girl Show*, written by Sherry Coben and directed by David Lee Strasberg, is getting rave reviews. The bracingly honest personal story of one aspiring actress in a city full of aspiring actresses has the industry abuzz. Check out [rachelbailit.com](http://rachelbailit.com) for more information. Two women, making their mark in 2006—there's truly nothing better. ★

De Boulle Diamond & Jewelry, Inc.,	:	
	:	
Opposer,	:	Consolidated Opposition No.: 91162370
	:	Opposition Nos. 91162370
v.	:	91162469
	:	91164615
De Beers LV Ltd.,	:	91165285
	:	91165465
Applicant.	:	
	:	

1. I am a partner in the firm of Kirkpatrick & Lockhart Preston Gates Ellis LLP, attorneys for Applicant, De Beers Diamond Jewellers Limited, formerly De Beers LV Ltd., (“De Beers”) in this Consolidated Opposition Proceeding.

2. I submit this Declaration in support of De Beers' Cross-Motion for Partial Summary Judgment and Response in Opposition to Opposer's, De Boule Diamond & Jewelry, Inc. (hereinafter "De Boule" or "Opposer"), Motion for Summary Judgment, pursuant to Fed. R. Civ. P. 56.

3. Attached hereto as Exhibit A is a true and correct copy of the Complaint filed in the civil action in the U.S. District Court of the Northern District of Texas, captioned *De Boulle Diamond & Jewelry, Inc. v. Colibri Corp.*, Civil Action No. 3:06-CV-0794-M.

4. Attached hereto as Exhibit B are true and correct copies of printouts from Opposer's web site.

5. Attached hereto as Exhibit C is a true and correct copy of Opposer's Response to De Beers' Request for Admission No. 22 dated December 30, 2005.

6. Attached hereto as Exhibit D are true and correct copies of Opposer's Notice of Opposition against the trademark application for "DB LOGO" (Opposition No. 91162370 – filed on September 27, 2004) and Opposer's Notice of Opposition against the trademark application for "DB MONOGRAM" (Opposition No. 91162469 – filed on September 27, 2004).

7. Attached hereto as Exhibit E is a true and correct copy of Opposer's Notice of Opposition against the trademark application for "DB SIGNATURE" (Opposition No. 91164615 – filed on March 14, 2005).

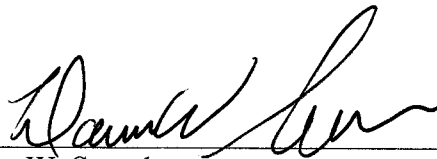
8. Attached hereto as Exhibit F are true and correct copies of Opposer's Notice of Opposition against the trademark application for "SO DB" (Opposition No. 91165465 – filed on May 13, 2005) and Opposer's Notice of Opposition against the trademark application for "DB STAR" (Opposition No. 91165285 – filed on May 13, 2005).

9. Attached hereto as Exhibit G are true and correct copies of the specimens submitted by Opposer for its U.S. trademark application for "DB" (Serial No. 78/604,056).

10. Attached hereto as Exhibit H are true and correct copies of documents produced by Opposer in this consolidated proceeding (production nos. 00477-00480, 00489-00491, 00499).

I declare under penalty of perjury that the foregoing is true and correct.

Dated: New York, New York  
January 4, 2008

  
Darren W. Saunders

## **EXHIBIT A**

ORIGINAL<sup>FOR</sup>

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

DE BOULLE DIAMOND &  
JEWELRY, INC.,

Plaintiff,

**VS.**

COLIBRI CORPORATION,

Defendant.



CASE NO. **3-06CV0794-M**

230481

**COMPLAINT AND PETITION FOR  
PARTIAL CANCELLATION OF TRADEMARK  
AND JURY DEMAND**

Plaintiff, De Boulle Diamond & Jewelry, Inc., through its undersigned counsel of record, submits its Complaint and Petition for Partial Cancellation of Trademark against Colibri Corporation, Defendant, and, in support thereof, allege the following:

I.

### Summary of Action

1. This action is brought under Sections 14 and 37 of the Lanham Act, 15 U.S.C. Sections 1064 and 1119.
2. Plaintiff seeks the partial cancellation of Federal trademark registration, Registration No. 1391538, dated April 29, 1986, by virtue of the Registrant's limited use and abandonment of the mark, as registered, by deletion from the recitation of the

particular goods or services included in the registration, all items of women's jewelry, diamonds, watches, and timepieces, on the grounds of the abandonment of the mark for use in association with such segments of the Class "Jewelry".

## II.

### **Jurisdiction and Venue**

3. This Court has jurisdiction over all aspects of this action pursuant to 28 U.S.C. Section 1331, in that this action arises under the Constitution, laws, or treaties of the United States, more specifically the Lanham Act, Title 15 of the United States Code (the "Lanham Act"). Jurisdiction is further specifically conferred upon this Court by Section 39 of the Lanham Act, 15 U.S.C. Section 1121.

4. This Court has personal jurisdiction over the Defendant in that:

- (a) Such jurisdiction is authorized by Tex. Civ. Prac. & Rem. Code Ann. §17.041 et seq. (the "Long-Arm Statute");
- (b) Defendant markets and sells its products in association with the mark in issue in this lawsuit through a network of authorized dealers throughout the State of Texas, at least thirty (30) of which are located in this District. In addition, Defendant markets and sells its products in association with the mark through an electronic catalog on its Web site, targeting consumers in the State of Texas, including in this District, directing such consumers to its network of authorized dealers throughout the State of Texas, by a search engine and system of toll-free numbers, organized by State and zip code. Defendant further markets and sells its products in association with the mark through advertising targeted at consumers in the State of Texas, including in this District, to include printed catalogs bearing products with the mark in issue, distributed to consumers in Texas through its network of authorized dealers, and, upon information and belief, other traditional forms of advertising and marketing. Defendant additionally markets and sells its products in association with the mark through agents and representatives located in the State and/or that travel to the State and District for purposes of selling and

making available for sale products bearing the mark in issue in this lawsuit in retail stores located throughout the State of Texas, including in this District;

- (c) In the ordinary course of business and specifically with regard to the transactions herein complained of, Defendant has conducted business within the State of Texas sufficient to satisfy the jurisdictional requirements of §17.042 of the Long-Arm Statute;
- (d) The causes of action asserted herein are connected with such acts or transaction business; and
- (e) The assumption of jurisdiction will not offend traditional notions of fair play and substantial justice, and equity demands that this Court assumes jurisdiction over the person of the Defendant.

5. Venue is proper in this district pursuant to 28 U.S.C. Section 1391(b) and (c), in that a substantial part of the events or omissions giving rise to the claims occurred in the District, Defendant is subject to personal jurisdiction in the District at the time this action is brought, and Defendant is deemed to reside in the District.

### III.

#### **The Parties**

6. Plaintiff, deBoulle Diamond & Jewelry, Inc. ("Plaintiff" and/or "deBoulle") is a corporation duly organized and existing under the laws of the State of Texas, with its principal place of business in Dallas County, Texas.

7. Defendant Colibri Corporation ("Defendant" and/or "Colibri"), is a Rhode Island corporation, with its principal place of business in Providence, Rhode Island. Said Defendant is a "Nonresident" as that term is defined in Tex. Civ. Prac. & Rem. Code Ann. §17.041 et seq. (the "Long-Arm Statute"), and is not, according to the Texas Secretary of State, currently registered to do business in the State of Texas. Said Defendant has done



business in the State of Texas, as that term is defined in §17.042 of the Long-Arm Statute, and **may be served with process herein by forwarding a copy of this pleading and Citation to the Texas Secretary of State**, as its agent for service of process pursuant to §17.044(b) of the Long-Arm Statute, **who is requested to serve Defendant Colibri Corporation at its home office at 100 Niantic Ave., Providence, RI 02907, Attention: Frederick N. Levinger, President, pursuant to §17.045(a) of the Long-Arm Statute.**

IV.

**Petition for Partial Cancellation of Trademark**

8. On or about April 29, 1986, Dolan & Bullock Co., a Rhode Island corporation ("Dolan & Bullock"), obtained Federal trademark registration, Registration No., 1391538, for the following stylized design containing the letters "db"( the "Colibri Mark"):



The registration was obtained pursuant to Section 1(a) of the Trademark Act, for the Class "Jewelry". On or about December 30, 1993, Dolan & Bullock, assigned the Colibri Mark to Park Lane Associates Inc., a Rhode Island corporation ("Park Lane"). On or about January 1, 2004, Park Lane assigned the Colibri Mark to Defendant. According to the

records of the United States Patent and Trademark Office, Defendant is the current owner of the Colibri Mark.

9. Upon information and belief, Dolan & Bullock, Park Lane and Colibri (collectively the "Registrant") have used the Colibri Mark solely in association with the sale of men's jewelry; specifically, men's cuff links, dress sets (matching cuff links and shirt studs), pocket watches, money clips, key rings, bracelets; and tie jewelry (the "Colibri Products"). Defendant sells and markets its line of women's jewelry in association with the mark "Krementz". Upon further information and belief, the Registrant has never made use of the Colibri Mark in connection with the sale of women's jewelry, diamonds, watches, or timepieces in the United States and/or commerce with the United States and/or has ceased use of the Colibri Mark in association with such products for at least two (2) years.

10. Plaintiff owns and operates a jewelry store in Dallas, Texas under the trade name and mark "De Boule", and has done so since 1984. Plaintiff, has also marketed and sold diamonds, fine jewelry and timepieces to the general public in Dallas, Texas, and elsewhere in the United States in association with the marks "DeB" and "DB" (collectively the "deBoule Marks"), used in the advertisement, rendition, and sale of its diamonds, fine jewelry, watches, and timepieces, and has done so continuously from at least subsequent to June 2001. deBoule's marketing activities include advertising and promoting its brand and products in local and national media. deBoule further promotes its brand and offers its "deBoule Collection" and other products for sale to general public throughout the United States on its Web site. Through the years, the deBoule Marks and brand has developed a

reputation in Dallas, Texas, and elsewhere in the United States for, and consumers have come to identify the deBoulle Marks with, the fine quality of the exclusive jewelry that the deBoulle craftsmen custom design and manufacture, as well as the fine quality of its diamonds and other gems.

11. deBoulle filed applications for federal registration of its deBoulle Marks on the basis of Section 1(a) of the Trademark Act, 15 USC Section 1501(a), on the following dates: (i) application for federal registration of the Mark "DB", U.S. Trademark Application Serial No. 78/604,056, applied April 7, 2005 (the "DB Mark"); (ii) application for federal registration of the Mark "DE BOULLE", U.S. Trademark Application Serial No. 78/444,880, applied July 1, 2004 (the "DE BOULLE Mark"); and (iii) application for federal registration of the Mark "DE B" and Design, U.S. Trademark Application Serial No. 78/440,907, applied July 1, 2004 (the "DE B Mark"). deBoulle desires to register the deBoulle Marks in Classes 14 (jewelry, diamonds, watches) and 35 (retail jewelry stores, catalogue sales, and web based sales).

12. Through an Office Action in U.S. Trademark Application Serial No. 78/604,056, the United States Patent and Trademark Office has indicated that deBoulle's DB Mark could be confusingly similar to the Colibri Mark and that it would deny registration of the DB Mark on that basis.

13. deBoulle would respectfully show the Court that the Registrant has abandoned the Colibri Mark in most if not all of the segment of the jewelry and watch market targeted and served by deBoulle. The Colibri Mark consists of a highly stylized rendition of the letters "db", and has been used solely in association with a very narrow

and specific category of men's jewelry, namely the Colibri Products, sold mainly through tobacco shops and other men's accessory stores, and not through high-end, luxury jewelry stores, and Web sites, in competition with Plaintiff's business. In addition, the Colibri Mark is not sold or marked in association with women's jewelry, diamonds, watches, and timepieces, at all, and/or has ceased use of the Colibri Mark in association with such products for at least two (2) years. The Colibri Mark is therefore not applied to goods or services which are identical as those sold by the Plaintiff. Furthermore, the stylized rendition of the Colibri Mark is unique and deBoulle's use of the deBoulle Marks will not cause confusion or deception as to the origin of the deBoulle Marks and/or the Colibri Mark.

14. Plaintiff will be greatly damaged and harmed if it were to be precluded from using the deBoulle Marks, in which it has acquired considerable goodwill and brand identification, in the advertisement, rendition, and sale of its diamonds, fine jewelry and timepieces, to the predominant segment of the jewelry market not served or targeted by the Defendant, if the Defendant is permitted to continue to maintain its registration. The continued existence of Defendant's registration of the Colibri Mark, casts a cloud upon Plaintiff's right to continue to use, register, and expand the use of the deBoulle Marks, all by virtue of the Defendant's limited use of the Colibri Mark.

15. By virtue of such damage and harm, Plaintiff petitions the Court, pursuant to Sections 14 and 37 of the Lanham Act, 15 U.S.C. Sections 1064 and 1119, that Defendant's Federal trademark registration, Registration No., 1391538, as registered, be cancelled in part, as a result of the Registrant's limited use and abandonment of the Colibri

Mark, for all segments of the Class "Jewelry", other's than men's jewelry and pocket watches. Defendant does not market or sell any of the goods or services for which this partial cancellation is sought in association with the Colibri Mark.


V.

**Prayer**

WHEREFORE PREMISES CONSIDERED, deBoulle Diamond and Jewelry, Inc., Plaintiff, prays that:

- (i) Plaintiff have and recover judgment of and against Defendant: (a) Pursuant to Section 14 of the Lanham Act, 15 U.S.C. Section 1064, that the Registrant's has abandoned of the Mark evidenced by Federal trademark registration, Registration No., 1391538, for use in association with women's jewelry, diamonds, watches, and timepieces; and (b) pursuant to Section 37 of the Lanham Act, 15 U.S.C. Section 1119, that Federal trademark registration, Registration No., 1391538, be amended by deletion from the particular goods or services from the recitation of goods and services included in the registration, all items of women's jewelry, diamonds, watches, and timepieces, to reflect such abandonment; and
- (ii) Plaintiff have and recover such other and further relief, legal and equitable, general and special, to which Plaintiff may show itself justly entitled.

Respectfully submitted,



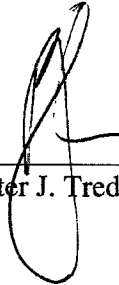
---

Pieter J. Tredoux  
(Member of the New York Bar)  
1717 Main Street  
Suite 3400  
Dallas, Texas 75201  
214-712-9291 – [telephone]  
214-712-5690 – [telecopier]

COUNSEL FOR PLAINTIFF

**JURY DEMAND**

Plaintiff demands a trial by jury by the maximum number of jurors permitted by law of all issues so triable.



---

Pieter J. Tredoux

The JS 44 civil cover sheet and the information contained herein neither replace nor supplement the filing and service of pleadings or other papers as required by law, except as provided by local rules of court. This form, approved by the Judicial Conference of the United States in September 1974, is required for the use of the Clerk of Court for the purpose of initiating the civil docket sheet. (SEE INSTRUCTIONS ON THE REVERSE OF THE FORM)

**I. (a) PLAINTIFFS**

De Boule Diamond &amp; Jewelry, Inc.

**DEFENDANTS**

Golibri Corporation

(b) County of Residence of First Listed Plaintiff

Dallas, Texas

County of Residence of First Listed Defendant

Providence County, RI

(EXCEPT IN U.S. PLAINTIFF CASES)

(IN U.S. PLAINTIFF CASES ONLY)

NOTE: IN LAND CONDEMNATION CASES, USE THE LOCATION OF THE LAND INVOLVED.

(c) Attorney's (Firm Name, Address, and Telephone Number)

Pieter J. Tredoux, 1717 Main Street, Suite 3400, Dallas, Texas 75201  
214.712.9291

Attorneys (If Known)

**3-06CV0794-M****II. BASIS OF JURISDICTION** (Place an "X" in One Box Only)

- ☐ 1 U.S. Government Plaintiff
- ☒ 3 Federal Question (U.S. Government Not a Party)
- ☐ 2 U.S. Government Defendant
- ☐ 4 Diversity (Indicate Citizenship of Parties in Item III)

**III. CITIZENSHIP OF PRINCIPAL PARTIES** (Place an "X" in One Box for Plaintiff and One Box for Defendant)

- |   | PTF                        | DEF                        |   | PTF                                   | DEF                                   |
|---|----------------------------|----------------------------|---|---------------------------------------|---------------------------------------|
| Citizen of This State                   | <input type="checkbox"/> 1 | <input type="checkbox"/> 1 | Incorporated or Principal Place of Business In This State     | <input checked="" type="checkbox"/> 4 | <input type="checkbox"/> 4            |
| Citizen of Another State                | <input type="checkbox"/> 2 | <input type="checkbox"/> 2 | Incorporated and Principal Place of Business In Another State | <input type="checkbox"/> 5            | <input checked="" type="checkbox"/> 5 |
| Citizen or Subject of a Foreign Country | <input type="checkbox"/> 3 | <input type="checkbox"/> 3 | Foreign Nation  | <input type="checkbox"/> 6            | <input type="checkbox"/> 6            |

**IV. NATURE OF SUIT** (Place an "X" in One Box Only)

CONTRACT	TORTS	FORFEITURE/PENALTY	BANKRUPTCY	OTHER STATUTES
<input type="checkbox"/> 110 Insurance <input type="checkbox"/> 120 Marine <input type="checkbox"/> 130 Miller Act <input type="checkbox"/> 140 Negotiable Instrument <input type="checkbox"/> 150 Recovery of Overpayment & Enforcement of Judgment <input type="checkbox"/> 151 Medicare Act <input type="checkbox"/> 152 Recovery of Defaulted Student Loans (Excl. Veterans) <input type="checkbox"/> 153 Recovery of Overpayment of Veteran's Benefits <input type="checkbox"/> 160 Stockholders' Suits <input type="checkbox"/> 190 Other Contract <input type="checkbox"/> 195 Contract Product Liability <input type="checkbox"/> 196 Franchise	<b>PERSONAL INJURY</b> <input type="checkbox"/> 310 Airplane <input type="checkbox"/> 315 Airplane Product Liability <input type="checkbox"/> 320 Assault, Libel & Slander <input type="checkbox"/> 330 Federal Employers' Liability <input type="checkbox"/> 340 Marine <input type="checkbox"/> 345 Marine Product Liability <input type="checkbox"/> 350 Motor Vehicle <input type="checkbox"/> 355 Motor Vehicle Product Liability <input type="checkbox"/> 360 Other Personal Injury <b>PERSONAL PROPERTY</b> <input type="checkbox"/> 362 Personal Injury - Med. Malpractice <input type="checkbox"/> 365 Personal Injury - Product Liability <input type="checkbox"/> 368 Asbestos Personal Injury Product Liability <input type="checkbox"/> 370 Other Fraud <input type="checkbox"/> 371 Truth in Lending <input type="checkbox"/> 380 Other Personal Property Damage <input type="checkbox"/> 385 Property Damage Product Liability	<input type="checkbox"/> 610 Agriculture <input type="checkbox"/> 620 Other Food & Drug <input type="checkbox"/> 625 Drug Related Seizure of Property 21 USC 881 <input type="checkbox"/> 630 Liquor Laws <input type="checkbox"/> 640 R.R. & Truck <input type="checkbox"/> 650 Airline Regs. <input type="checkbox"/> 660 Occupational Safety/Health <input type="checkbox"/> 690 Other <b>LABOR</b> <input type="checkbox"/> 710 Fair Labor Standards Act <input type="checkbox"/> 720 Labor/Mgmt. Relations <input type="checkbox"/> 730 Labor/Mgmt. Reporting & Disclosure Act <input type="checkbox"/> 740 Railway Labor Act <input type="checkbox"/> 790 Other Labor Litigation <input type="checkbox"/> 791 Empl. Ret. Inc. Security Act	<input type="checkbox"/> 422 Appeal 28 USC 158 <input type="checkbox"/> 423 Withdrawal 28 USC 157 <b>PROPERTY RIGHTS</b> <input type="checkbox"/> 820 Copyrights <input type="checkbox"/> 830 Patent <input checked="" type="checkbox"/> 840 Trademark <b>SOCIAL SECURITY</b> <input type="checkbox"/> 861 HIA (1395ff) <input type="checkbox"/> 862 Black Lung (923) <input type="checkbox"/> 863 DIWC/DIWW (405(g)) <input type="checkbox"/> 864 SSID Title XVI <input type="checkbox"/> 865 RSI (405(g)) <b>FEDERAL TAX SUITS</b> <input type="checkbox"/> 870 Taxes (U.S. Plaintiff or Defendant) <input type="checkbox"/> 871 IRS—Third Party 26 USC 7609	<input type="checkbox"/> 400 State Reapportionment <input type="checkbox"/> 410 Antitrust <input type="checkbox"/> 430 Banks and Banking <input type="checkbox"/> 450 Commerce <input type="checkbox"/> 460 Deportation <input type="checkbox"/> 470 Racketeer Influenced and Corrupt Organizations <input type="checkbox"/> 480 Consumer Credit <input type="checkbox"/> 490 Cable/Sat TV <input type="checkbox"/> 810 Selective Service <input type="checkbox"/> 850 Securities/Commodities/Exchange <input type="checkbox"/> 875 Customer Challenge 12 USC 3410 <input type="checkbox"/> 890 Other Statutory Actions <input type="checkbox"/> 891 Agricultural Acts <input type="checkbox"/> 892 Economic Stabilization Act <input type="checkbox"/> 893 Environmental Matters <input type="checkbox"/> 894 Energy Allocation Act <input type="checkbox"/> 895 Freedom of Information Act <input type="checkbox"/> 900 Appeal of Fee Determination Under Equal Access to Justice <input type="checkbox"/> 950 Constitutionality of State Statutes
<b>REAL PROPERTY</b> <input type="checkbox"/> 210 Land Condemnation <input type="checkbox"/> 220 Foreclosure <input type="checkbox"/> 230 Rent Lease & Ejectment <input type="checkbox"/> 240 Torts to Land <input type="checkbox"/> 245 Tort Product Liability <input type="checkbox"/> 290 All Other Real Property	<b>CIVIL RIGHTS</b> <input type="checkbox"/> 441 Voting <input type="checkbox"/> 442 Employment <input type="checkbox"/> 443 Housing/Accommodations <input type="checkbox"/> 444 Welfare <input type="checkbox"/> 445 Amer. w/Disabilities - Employment <input type="checkbox"/> 446 Amer. w/Disabilities - Other <input type="checkbox"/> 440 Other Civil Rights	<b>PRISONER PETITIONS</b> <input type="checkbox"/> 510 Motions to Vacate Sentence <b>Habeas Corpus:</b> <input type="checkbox"/> 530 General <input type="checkbox"/> 535 Death Penalty <input type="checkbox"/> 540 Mandamus & Other <input type="checkbox"/> 550 Civil Rights <input type="checkbox"/> 555 Prison Condition		

**V. ORIGIN**

- ☒ 1 Original Proceeding
- ☐ 2 Removed from State Court
- ☐ 3 Remanded from Appellate Court
- ☐ 4 Reinstated or Reopened
- ☐ 5 Transferred from another district (specify)
- ☐ 6 Multidistrict Litigation
- ☐ 7 Appeal to District Judge from Magistrate Judgment

Cite the U.S. Civil Statute under which you are filing (Do not cite jurisdictional statutes unless diversity):

**VI. CAUSE OF ACTION**

Brief description of cause: Petition for Partial Cancellation of Trademark under the the Lanham Act, Title 15 of the US Code

**VII. REQUESTED IN COMPLAINT:**☐ CHECK IF THIS IS A CLASS ACTION UNDER F.R.C.P. 23

DEMAND \$ N/A

CHECK YES only if demanded in complaint:

JURY DEMAND: ☒ Yes ☐ No**VIII. RELATED CASE(S) IF ANY**

(See instructions):

JUDGE

DOCKET NUMBER

DATE

SIGNATURE OF ATTORNEY OF RECORD

May 3, 2006

FOR OFFICE USE ONLY

RECEIPT #

AMOUNT

APPLYING IFP

JUDGE

MAG. JUDGE

## **EXHIBIT B**



# deBoullé™

when it is time for something special

HOME

DIAMONDS

FINE JEWELRY

TIMEPIECES

ACCESSORIES

CUSTOM DESIGNS

*The deBoullé Collection*

EVENT RSVP

ENTER



Contact Customer Service at 1-800-454-GEMS or email [customersfirst@deBoullé](mailto:customersfirst@deBoullé)

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deBoullé



## Welcome to deBoullé.com

when it is time for something special : 1-

HOME

\*\*\*\*\*

DIAMONDS

FINE JEWELRY

TIMEPIECES

ACCESSORIES

CUSTOM DESIGNS

*The deBoullé Collection*

\*\*\*\*\*

ABOUT US

CONTACT US

YOUR PRIVACY

JEWELER'S GUIDE

\*\*\*\*\*

THE  
deBoullé  
D-FLAWLESS  
GUARANTEE



You are about to experience the beauty, quality and fine craftsmanship of the deBoullé Collection. Until now, this world-class array of diamonds, fine jewelry and timepieces has been available only to the loyal clientele of our salon in Dallas, Texas.

Over the past two decades, deBoullé has built a reputation as one of the pre-eminent, independently-owned jewelers in the United States. deBoullé is renowned for the beauty, quality and fine craftsmanship of its collection. Now all this is presented to you online for your unique shopping pleasure.



Contact Customer Service at 1-800-454-GEMS or email [customersfirst@deBoullé](mailto:customersfirst@deBoullé)

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deBoulle<sup>®</sup>

## FINE JEWELRY

when it is time for something special : 1-

HOME

DIAMONDS

FINE JEWELRY

TIMEPIECES

ACCESSORIES

CUSTOM DESIGNS

*The deBoulle Collection*

ABOUT US

CONTACT US

YOUR PRIVACY

JEWELER'S GUIDE

THE  
deBoulle  
D-FLAWLESS  
GUARANTEE



deBoulle is an authorized dealer for seventeen luxury jewelry brands. Over the years, the fine designers and craftsmen at deBoulle have also created the exquisite deBoulle Collection, which can be viewed in our e-commerce salon. You may view our collection of fine jewelry by selecting the category of your choice, or search our inventory by clicking on the search button below.



©B *The deBoulle Collection*

*Luxury jewelry  
you'll find*

Bvlgari  
Carrera  
Charles  
Deakin &  
deBoulle  
Emsaru  
Favero  
Fred Lei  
JB Star  
Kurt Wa  
Kwiat  
Luca Ca  
Mariani  
Mitchell  
Mouwac  
Oscar H  
Richard

Contact Customer Service at 1-800-454-GEMS or email [customersfirst@deBoulle](mailto:customersfirst@deBoulle)

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## **EXHIBIT C**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

	x	
	§	
DEBOULLE DIAMOND & JEWELRY, INC.,	§	
	§	
Opposer,	§	
	§	Consolidated Opposition
v.	§	No. 91165285
	§	
DE BEERS LV LTD.,	§	
	§	
Applicant.	§	
	x	

**OPPOSER'S OBJECTIONS AND ANSWERS TO  
APPLICANT'S FIRST REQUEST FOR ADMISSIONS**

TO: Applicant, De Beers LV Ltd., by and through its attorneys: Mark I. Peroff, Esq.,  
Darren W. Saunders, Esq., and Melanie Bradley, Esq., Kirkpatrick & Lockhart  
Nicholson Graham, LLP, 599 Lexington Avenue, New York, NY 10022-6030

Opposer, De Boulle Diamond & Jewelry, Inc. ("Opposer" and/or "De Boulle"), hereby submits its Objections and Answers to Applicant, De Beers LV Ltd.'s ("Applicant" and/or "De Beers") First Requests for Admissions pursuant to Rules 26, and 36 of the Federal Rules of Civil Procedure, 37 CFR §§2.116 and 2.120, and Trademark Trial and Appeal Board Manual of Procedure, Chapter 400 (collectively the "TBMP").

This the 36 day of December, 2005.

Respectfully submitted,



---

Pieter J. Tredoux  
E-Mail Address:  
ptredoux@tredoux.com  
[Member of the New York Bar]  
300 Park Avenue, Suite 1700  
New York, New York 10022  
(212) 308-3500

- and -

David A. Harlow  
NELSON MULLINS RILEY & SCARBOROUGH LLP  
E-Mail Address:  
david.harlow@nelsonmullins.com  
NC Bar No. 1887  
4140 Parklake Avenue  
GlenLake One / Second Floor  
Post Office Box 30519 (27622-0519)  
Raleigh, North Carolina 27612  
(919) 877-3800

CO-COUNSEL FOR OPPOSER

Opposer objects to this request in that it is vague, ambiguous, overly broad, and misleading, in that, as worded, it implies that the trade name DeBeers was used in trade and commerce in the United States, prior to launching Applicant's first store in New York, and that the DeBeers brand has been distinguished world wide only for its mining and wholesale trade of diamonds, and not for the notoriety associated with its monopolistic business practices, violation of American law, involvement in the trade in blood diamonds, and its long-time association with the South African Apartheid regime. The request as worded is therefore denied.

21. Each of Applicant's marks contains an additional element other than the initials "D" and "B".

ANSWER:

Deny

22. Opposer is not aware of any instances of actual confusion between products sold under Opposer's marks and Applicant's marks.

ANSWER:

Admit

## **EXHIBIT D**



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of	)
	)
Application Serial Number 78/245,219	)
	)
Mark: DB LOGO	)
	)
Published: August 17, 2004	)
	)
De Boulle Diamond & Jewelry, Inc.,	)
Opposer,	)
	)
v.	)
De Beers LV Ltd	)
Applicant	)

**NOTICE OF OPPOSITION**

De Boulle Diamond & Jewelry, Inc., a corporation organized and existing under the laws of the state of Texas and having its principal place of business at 6821 Preston Road, Dallas, TX 75205, (hereinafter "De Boulle" or "Opposer"), believes that it will be damaged by registration of the mark shown in application Serial Number 78/245,219 in International Class 014, and hereby opposes the same.

The opposition is based on 15 U.S.C. § 1063(a), and the grounds for this opposition are as follows:

**CERTIFICATE OF MAILING BY "EXPRESS MAIL"**  
"Express Mail" mailing label number EV409767878US

I hereby certify that this correspondence is addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-35 13, BOX TTAB — FEE, and is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 3 CFR 1.10 on the date noted below.

Kathlyn Hunter

Name of person mailing paper or fee

(Signature of person mailing paper or fee)

September 27, 2004

(Date of signature)

09/30/2004 KSDMCHAN 00000065 78245219

01 FC:6402

300.00 00



09-27-2004

U.S. Patent & TMO/TM Mail Rpt Dt. #22

1. Extension of time, to and including December 15, 2004, was requested by and duly granted to Opposer pursuant to 37 C.F.R. §2.102.

2. De Beers LV Ltd., a corporation organized under the laws of the United Kingdom (hereinafter "De Beers" or "Applicant") seeks to register its mark DB LOGO as a trademark for the following goods in International Class 014 (hereinafter "Applicant's Goods"), as evidenced by publication of said Mark in the Official Gazette on page TM 231 of the August 17, 2004 issue:

In International Class 014 for precious metals and their alloys and goods in precious metals or coated therewith not included in other classes, namely beverage ware and dishes of precious metal, candle snuffers and candlesticks of precious metal, napkins rings of precious metal, vases of precious metal, jewel cases of precious metal, statues of precious metal, rings, necklaces, bracelets, earrings, brooches, diadems made of precious metal or coated therewith, jewelry and imitation jewelry; gemstones; precious stones, semi-precious stones; diamonds; watches, clocks, horological and chronometric instruments, namely chronometers, chronographs for use as watches, watch bracelets, watch cases, pocket watches, wristwatches, watch movements; replacement parts for all the aforesaid goods.

3. Applicant acquired no rights in Applicant's mark in the United States prior to May 2, 2003, when Applicant filed its Intent to Use application for Applicant's DB LOGO mark in the United States Patent and Trademark Office with a Section 44(d) claimed priority date from a United Kingdom application filed November 5, 2002.

4. Prior to the filing date for Applicant's Mark, and any priority date or date of use which Applicant can rely on, Opposer has for many years used "deB" marks for the following goods (hereinafter "Opposer's Goods"):

In International Class 014 Jewelry, diamonds, watches and timepieces, and fine art.

In International Class 035 Retail jewelry store services via physical store, catalogue sales and web-based sales.

5. Opposer has used a particular stylized version of the “deB” mark, which is a “deB” logo, since at least as early as June 30, 2001. This stylized version of the mark is the subject of a pending trademark application filed July 1, 2004, USPTO Serial No. 78/444,907.

6. Opposer has spent substantial amounts of time, money and effort in developing and marketing Opposer’s Goods under Opposer’s “deB” mark in the United States and sales of Opposer’s Goods under Opposer’s “deB” mark have amounted to many millions of dollars. As a result, members of the general public have come to identify Opposer’s “deB” mark with Opposer’s Goods and to recognize Opposer’s Goods to be of the highest quality and originating from Opposer.

7. Because of Opposer’s marketing efforts and sales, Opposer has established a prominent presence in the retail jewelry marketplace as a leading provider of high quality jewelry and timepieces. Through the distinctiveness of Opposer’s “deB” mark and through widespread and favorable public recognition and acceptance in the retail jewelry market and, in particular, in the area of high quality jewelry, Opposer’s “deB” mark has become uniquely associated with Opposer and is famous, distinctive and well-known.

8. Applicant’s DB LOGO mark is very similar in appearance and commercial impression to Opposer’s “deB” mark, with both marks having the phonetically identical DB or “deB” as the dominant term. Importantly, Applicant’s DB LOGO mark and Opposer’s “deB” mark are for identical goods in International Class 014, namely, jewelry and timepieces. Applicant has, thus, expressed an intent to use Applicant’s DB LOGO mark on goods that are identical to Opposer’s Goods and/or goods that are within Opposer’s natural area of expansion. Any use of its mark by the Applicant which would emphasize the DB part of its mark and/or de-emphasize the LOGO part of its mark would result in near identical marks and cause clear and obvious confusion in the marketplace.

9. On information and belief, it is expected that Applicant’s Goods will be marketed to the same potential purchasers in the same relevant markets as the goods now marketed by Opposer and/or the goods within Opposer’s natural area of expansion. Moreover, it is expected that

Applicant will use similar media to advertise Applicant's Goods under Applicant's DB LOGO mark as used by Opposer to advertise Opposer's Goods under Opposer's "deB" mark.

Additionally, it is expected that the goods marketed under Applicant's DB LOGO mark will be distributed through the same channels of distribution and will be purchased and used by many of the same individuals and entities as those of the Opposer's Goods.

10. As a result of the substantial similarities between the marks' respective appearances, underlying goods, relevant markets, advertising, channels of distribution, purchasers, and users, Opposer believes that there is a very strong likelihood of confusion if Applicant is permitted to register Applicant's DB LOGO mark for use in conjunction with Applicant's Goods.

11. Opposer's marketing efforts have caused Opposer and Opposer's "deB" mark to be well-known and well-regarded in the community of consumers who are likely to consider purchasing Applicant's Goods. Therefore, it is likely that some members of the relevant consumer market would be confused by the marketing of Applicant's Goods under Applicant's DB LOGO mark and would believe that Applicant's Goods were associated with, endorsed by, related to, or actually the goods of Opposer. Any fault or defect in Applicant's Goods would reflect upon and seriously injure Opposer's reputation. Furthermore, individuals or entities who are familiar with Opposer's "deB" mark would confuse the same with Applicant's DB LOGO mark and might purchase Applicant's Goods in the mistaken belief that they are purchasing the goods of Opposer.

12. If Applicant is granted the registration herein opposed, Applicant would be placed in a position to deceive or mislead the public, as the registration would give Applicant certain rights to Applicant's DB LOGO mark and all confusingly similar marks, thereby causing damage and injury to Opposer.

13. As a result of the substantial similarities between the marks' respective appearances, underlying goods, relevant markets, advertising, channels of distribution, purchasers, and users, registration of Applicant's DB LOGO mark would cause damage and injury to Opposer.

14. Because Applicant's DB LOGO mark consists of a mark which closely resembles a senior mark of Opposer, Applicant's DB LOGO mark is likely, when used in connection with the goods of Applicant, to cause confusion, to cause mistake, or to deceive, and registration of Applicant's DB LOGO mark is therefore barred under 15 U.S.C. § 1052(d).

15. Further, Opposers' "deB" mark is a distinctive and famous mark within the meaning of same set forth in 15 U.S.C. § 1125(c). The use of Applicant's DB LOGO mark by Applicant as stated in its intent to use application is for a commercial use in interstate commerce beginning after Opposer's "deB" mark has become famous, and, given the similarities of the marks, such use by Applicant would cause dilution of the distinctive quality of Opposer's "deB" mark by lessening the capacity of Opposer's "deB" mark to identify and distinguish goods or services.

16. Given that Applicant's use of Applicant's DB LOGO mark by Applicant as stated in its intent to use application is for a commercial use in interstate commerce and that such use would dilute the distinctive quality of Opposer's famous "deB" mark, registration of Applicant's DB LOGO mark would cause damage and injury to Opposer.

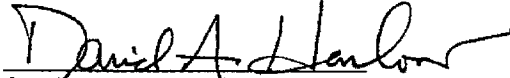
17. Because Applicant's DB LOGO mark consists of a mark which would cause dilution of the distinctive quality of Opposer's "deB" mark, registration of Applicant's DB LOGO mark is therefore also barred as a matter of equity under 15 U.S.C. § 1125(c) and should be refused under 15 U.S.C. § and 1063(a).

18. Accordingly, Opposer prays that said Application Serial Number 78/245,219 is rejected and the registration of the mark therein shown for the goods therein specified be refused and denied.

This Notice of Opposition is herewith submitted in triplicate, together with the filing fee in the amount of \$300. If the fees enclosed are not sufficient, or if any additional fees are

required, the Patent and Trademark Office is hereby authorized to charge our USPTO Deposit Account Number 502843 in the name of Nelson Mullins Riley & Scarborough LLP.

Respectfully submitted this 27th day of September, 2004.



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of )  
Application Serial Number 78/245,779 )  
Mark: DB MONOGRAM )  
Published: June 1, 2004 )  
De Boulle Diamond & Jewelry, Inc., )  
Opposer, )  
v. )  
De Beers LV Ltd )  
Applicant )

NOTICE OF OPPOSITION

De Boulle Diamond & Jewelry, Inc., a corporation organized and existing under the laws of the state of Texas and having its principal place of business at 6821 Preston Road, Dallas, TX 75205, (hereinafter "De Boulle" or "Opposer"), believes that it will be damaged by registration of the mark shown in application Serial Number 78/245,779 in International Class 014, and hereby opposes the same.

The opposition is based on 15 U.S.C. § 1063(a), and the grounds for this opposition are as follows:

<p>CERTIFICATE OF MAILING BY "EXPRESS MAIL" "Express Mail" mailing label number EV40976788108</p> <p>I hereby certify that this correspondence is addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, BOX TTAB - FEE, and is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 3 CFR 1.10 on the date noted below.</p> <p>Kathlyn Hunter Name of person mailing paper or fee</p> <p><i>Kathlyn Hunter</i> (Signature of person mailing paper or fee)</p> <p>September 27, 2004 (Date of signature)</p>
--

1. An extension of time, to and including September 29, 2004, was requested by and duly granted to Opposer pursuant to 37 C.F.R. §2.102.

2. De Beers LV Ltd., a corporation organized under the laws of the United Kingdom (hereinafter "De Beers" or "Applicant") seeks to register its mark DB MONOGRAM as a trademark for the following goods in International Class 014 (hereinafter "Applicant's Goods"), as evidenced by publication of said Mark in the Official Gazette on page TM 436 of the June 1, 2004 issue:

In International Class 014 for precious metals and their alloys and goods in precious metals or coated therewith not included in other classes, namely, jewelry and imitation jewelry; precious stones; semi-precious stones; diamonds; watches; clocks; chronometers and chronoscopes; replacement parts for all the aforesaid goods.

3. Applicant acquired no rights in Applicant's mark in the United States prior to May 5, 2003, when Applicant filed its Intent to Use application for Applicant's DB MONOGRAM mark in the United States Patent and Trademark Office with a Section 44(d) claimed priority date from a United Kingdom application filed November 15, 2002.

4. Prior to the filing date for Applicant's mark, and any priority date or date of use which Applicant can rely on, Opposer has for many years used "deB" marks for the following goods (hereinafter "Opposer's Goods"):

In International Class 014 Jewelry, diamonds, watches and timepieces, and fine art.

In International Class 035 Retail jewelry store services via physical store, catalogue sales and web-based sales.

5. Opposer has used a particular stylized version of the "deB" mark, which is a "deB" logo, since at least as early as June 30, 2001. This stylized version of the mark is the subject of a pending trademark application filed July 1, 2004, USPTO Serial No. 78/444,907.



6. Opposer has spent substantial amounts of time, money and effort in developing and marketing Opposer's Goods under Opposer's "deB" mark in the United States and sales of Opposer's Goods under Opposer's "deB" mark have amounted to many millions of dollars. As a result, members of the general public have come to identify Opposer's "deB" mark with Opposer's Goods and to recognize Opposer's Goods to be of the highest quality and originating from Opposer.

7. Because of Opposer's marketing efforts and sales, Opposer has established a prominent presence in the retail jewelry marketplace as a leading provider of high quality jewelry and timepieces. Through the distinctiveness of Opposer's "deB" mark and through widespread and favorable public recognition and acceptance in the retail jewelry market and, in particular, in the area of high quality jewelry, Opposer's "deB" mark has become uniquely associated with Opposer and is famous, distinctive and well-known.

8. Applicant's DB MONOGRAM mark is very similar in appearance and commercial impression to Opposer's "deB" mark, with both marks having the phonetically identical DB or "deB" as the dominant term. Importantly, Applicant's DB MONOGRAM mark and Opposer's "deB" mark are for identical goods in International Class 014, namely, jewelry and timepieces. Applicant has, thus, expressed an intent to use Applicant's DB MONOGRAM mark on goods that are identical to Opposer's Goods and/or goods that are within Opposer's natural area of expansion. Any use of its mark by the Applicant which would emphasize the DB part of its mark and/or de-emphasize the MONOGRAM part of its mark would result in near identical marks and cause clear and obvious confusion in the marketplace.

9. On information and belief, it is expected that Applicant's Goods will be marketed to the same potential purchasers in the same relevant markets as the goods now marketed by Opposer and/or the goods within Opposer's natural area of expansion. Moreover, it is expected that Applicant will use similar media to advertise Applicant's Goods under Applicant's DB MONOGRAM mark as used by Opposer to advertise Opposer's Goods under Opposer's "deB" mark. Additionally, it is expected that the goods marketed under Applicant's DB MONOGRAM mark will be distributed through the same channels of distribution and will be

purchased and used by many of the same individuals and entities as those of the Opposer's Goods.

10. As a result of the substantial similarities between the marks' respective appearances, underlying goods, relevant markets, advertising, channels of distribution, purchasers, and users, Opposer believes that there is a very strong likelihood of confusion if Applicant is permitted to register Applicant's DB MONOGRAM mark for use in conjunction with Applicant's Goods.

11. Opposer's marketing efforts have caused Opposer and Opposer's "deB" mark to be well-known and well-regarded in the community of consumers who are likely to consider purchasing Applicant's Goods. Therefore, it is likely that some members of the relevant consumer market would be confused by the marketing of Applicant's Goods under Applicant's DB MONOGRAM mark and would believe that Applicant's Goods were associated with, endorsed by, related to, or actually the goods of Opposer. Any fault or defect in Applicant's Goods would reflect upon and seriously injure Opposer's reputation. Furthermore, individuals or entities who are familiar with Opposer's "deB" mark would confuse the same with Applicant's DB MONOGRAM mark and might purchase Applicant's Goods in the mistaken belief that they are purchasing the goods of Opposer.

12. If Applicant is granted the registration herein opposed, Applicant would be placed in a position to deceive or mislead the public, as the registration would give Applicant certain rights to Applicant's DB MONOGRAM mark and all confusingly similar marks, thereby causing damage and injury to Opposer.

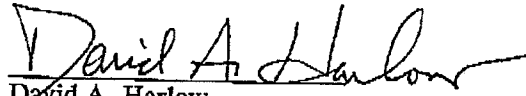
13. As a result of the substantial similarities between the marks' respective appearances, underlying goods, relevant markets, advertising, channels of distribution, purchasers, and users, registration of Applicant's DB MONOGRAM mark would cause damage and injury to Opposer.

14. Because Applicant's DB MONOGRAM mark consists of a mark which closely resembles a senior mark of Opposer, Applicant's DB MONOGRAM mark is likely, when used in connection with the goods of Applicant, to cause confusion, to cause mistake, or to deceive, and registration of Applicant's DB MONOGRAM mark is therefore barred under 15 U.S.C. § 1052(d).
15. Further, Opposers' "deB" mark is a distinctive and famous mark within the meaning of same set forth in 15 U.S.C. § 1125(c). The use of Applicant's DB MONOGRAM mark by Applicant as stated in its intent to use application is for a commercial use in interstate commerce beginning after Opposer's "deB" mark has become famous, and, given the similarities of the marks, such use by Applicant would cause dilution of the distinctive quality of Opposer's "deB" mark by lessening the capacity of Opposer's "deB" mark to identify and distinguish goods or services.
16. Given that Applicant's use of Applicant's DB MONOGRAM mark by Applicant as stated in its intent to use application is for a commercial use in interstate commerce and that such use would dilute the distinctive quality of Opposer's famous "deB" mark, registration of Applicant's DB MONOGRAM mark would cause damage and injury to Opposer.
17. Because Applicant's DB MONOGRAM mark consists of a mark which would cause dilution of the distinctive quality of Opposer's "deB" mark, registration of Applicant's DB MONOGRAM mark is therefore also barred as a matter of equity under 15 U.S.C. § 1125(c) and should be refused under 15 U.S.C. § and 1063(a).
18. Accordingly, Opposer prays that said Application Serial Number 78/245,779 is rejected and the registration of the mark therein shown for the goods therein specified be refused and denied.

This Notice of Opposition is herewith submitted in triplicate, together with the filing fee in the amount of \$300. If the fees enclosed are not sufficient, or if any additional fees are

required, the Patent and Trademark Office is hereby authorized to charge our USPTO Deposit Account Number 502843 in the name of Nelson Mullins Riley & Scarborough LLP.

Respectfully submitted this 27th day of September, 2004.



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Attorney for Opposer

## **EXHIBIT E**

TTAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of )  
 )  
Application Serial Number 78/245,210 )  
 )  
Mark: DB SIGNATURE )  
 )  
Published: March 8, 2005 )  
 )  
De Boulle Diamond & Jewelry, Inc., )  
Opposer, )  
 )  
De Beers LV Ltd )  
Applicant )

NOTICE OF OPPOSITION

De Boulle Diamond & Jewelry, Inc., a corporation organized and existing under the laws of the state of Texas and having its principal place of business at 6821 Preston Road, Dallas, TX 75205, (hereinafter "De Boulle" or "Opposer"), believes that it will be damaged by registration of the mark shown in application Serial Number 78/245,210 in International Class 014, and hereby opposes the same.

The opposition is based on 15 U.S.C. § 1063(a), and the grounds for this opposition are as follows:

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CERTIFICATE OF MAILING BY "EXPRESS MAIL"  
"Express Mail" mailing label number EV409767793US

I hereby certify that this correspondence is addressed to the Commissioner For Trademarks, P.O. Box 1451, Alexandria, Virginia 22313, BOX TTAB - FEE, and is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 3 CFR 1.10 on the date noted below.

Kathlyn Hunter

Name of person mailing paper or fee

(Signature of person mailing paper or fee)

(Date of signature)



03-14-2005

1. De Beers LV Ltd., a corporation organized under the laws of the United Kingdom (hereinafter "De Beers" or "Applicant") seeks to register its mark DB SIGNATURE as a trademark for the following goods in International Class 014 (hereinafter "Applicant's Goods"), as evidenced by publication of said Mark in the Official Gazette on page TM 232 of the March 8, 2005 issue:

In International Class 014 for precious metals and their alloys, namely, jewelry, imitation jewelry, gemstones; precious stones; semi-precious stones, diamonds, horological and chronometric instruments, namely, watches and clocks and parts thereof for all the aforementioned goods.

2. Applicant acquired no rights in Applicant's mark in the United States prior to May 2, 2003, when Applicant filed its Intent to Use application for Applicant's DB SIGNATURE mark in the United States Patent and Trademark Office with a Section 44(d) claimed priority date from a United Kingdom application filed November 5, 2002.

3. Prior to the filing date for Applicant's Mark, and any priority date or date of use which Applicant can rely on, Opposer has for many years used "DB" and "deB" marks for the following goods (hereinafter "Opposer's Goods"):

In International Class 014 Jewelry, diamonds, watches and timepieces, and fine art.

In International Class 035 Retail jewelry store services via physical store, catalogue sales and web-based sales.

4. Opposer has used a particular stylized version of the "deB" mark, which is a "deB" logo, since at least as early as June 30, 2001. This stylized version of the mark is the subject of a pending trademark application filed July 1, 2004, USPTO Serial No. 78/444,907.

5. Opposer has spent substantial amounts of time, money and effort in developing and marketing Opposer's Goods under Opposer's "DB" and "deB" marks in the United States and sales of Opposer's Goods under Opposer's "DB" and "deB" marks have amounted to many millions of dollars. As a result, members of the general public have come to identify

Opposer's "DB" and "deB" marks with Opposer's Goods and to recognize Opposer's Goods to be of the highest quality and originating from Opposer.

6. Because of Opposer's marketing efforts and sales, Opposer has established a prominent presence in the retail jewelry marketplace as a leading provider of high quality jewelry and timepieces. Through the distinctiveness of Opposer's "DB" and "deB" marks and through widespread and favorable public recognition and acceptance in the retail jewelry market and, in particular, in the area of high quality jewelry, Opposer's "DB" and "deB" marks have become uniquely associated with Opposer and is famous, distinctive and well-known.

7. Applicant's DB SIGNATURE mark is very similar in appearance and commercial impression to Opposer's "DB" and "deB" marks, with both marks having the identical DB or "deB" as the dominant term. Importantly, Applicant's DB SIGNATURE mark and Opposer's "DB" and "deB" marks are for identical goods in International Class 014, namely, jewelry and timepieces. Applicant has, thus, expressed an intent to use Applicant's DB SIGNATURE mark on goods that are identical to Opposer's Goods and/or goods that are within Opposer's natural area of expansion. Particularly, any use of its mark by the Applicant which would emphasize the DB part of its mark and/or de-emphasize the SIGNATURE part of its mark would result in near identical marks and cause clear and obvious confusion in the marketplace.

8. On information and belief, it is expected that Applicant's Goods will be marketed to the same potential purchasers in the same relevant markets as the goods now marketed by Opposer and/or the goods within Opposer's natural area of expansion. Moreover, it is expected that Applicant will use similar media to advertise Applicant's Goods under Applicant's DB SIGNATURE mark as used by Opposer to advertise Opposer's Goods under Opposer's "DB" and "deB" marks. Additionally, it is expected that the goods marketed under Applicant's DB SIGNATURE mark will be distributed through the same channels of distribution and will be purchased and used by many of the same individuals and entities as those of the Opposer's Goods.



9. As a result of the substantial similarities between the marks' respective appearances, underlying goods, relevant markets, advertising, channels of distribution, purchasers, and users, Opposer believes that there is a very strong likelihood of confusion if Applicant is permitted to register Applicant's DB SIGNATURE mark for use in conjunction with Applicant's Goods.

10. Opposer's marketing efforts have caused Opposer and Opposer's "DB" and "deB" marks to be well-known and well-regarded in the community of consumers who are likely to consider purchasing Applicant's Goods. Therefore, it is likely that some members of the relevant consumer market would be confused by the marketing of Applicant's Goods under Applicant's DB SIGNATURE mark and would believe that Applicant's Goods were associated with, endorsed by, related to, or actually the goods of Opposer. Any fault or defect in Applicant's Goods would reflect upon and seriously injure Opposer's reputation. Furthermore, individuals or entities who are familiar with Opposer's "DB" and "deB" marks would confuse the same with Applicant's DB SIGNATURE mark and might purchase Applicant's Goods in the mistaken belief that they are purchasing the goods of Opposer.

11. If Applicant is granted the registration herein opposed, Applicant would be placed in a position to deceive or mislead the public, as the registration would give Applicant certain rights to Applicant's DB SIGNATURE mark and all confusingly similar marks, thereby causing damage and injury to Opposer.

12. As a result of the substantial similarities between the marks' respective appearances, underlying goods, relevant markets, advertising, channels of distribution, purchasers, and users, registration of Applicant's DB SIGNATURE mark would cause damage and injury to Opposer.

13. Because Applicant's DB SIGNATURE mark consists of a mark which closely resembles senior marks of Opposer, Applicant's DB SIGNATURE mark is likely, when used in connection with the goods of Applicant, to cause confusion, to cause mistake, or to deceive,

and registration of Applicant's DB SIGNATURE mark is therefore barred under 15 U.S.C. § 1052(d).

14. Further, Opposers' "DB" and "deB" marks are distinctive and famous marks within the meaning of same set forth in 15 U.S.C. § 1125(c). The use of Applicant's DB SIGNATURE mark by Applicant as stated in its intent to use application is for a commercial use in interstate commerce beginning after Opposer's "DB" and "deB" marks have become famous, and, given the similarities of the marks, such use by Applicant would cause dilution of the distinctive quality of Opposer's "DB" and "deB" marks by lessening the capacity of Opposer's "DB" and "deB" marks to identify and distinguish goods or services.

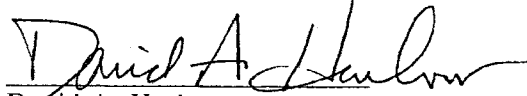
15. Given that Applicant's use of Applicant's DB SIGNATURE mark by Applicant as stated in its intent to use application is for a commercial use in interstate commerce and that such use would dilute the distinctive quality of Opposer's famous "DB" and "deB" marks, registration of Applicant's DB SIGNATURE mark would cause damage and injury to Opposer.

16. Because Applicant's DB SIGNATURE mark consists of a mark which would cause dilution of the distinctive quality of Opposer's "DB" and "deB" marks, registration of Applicant's DB SIGNATURE mark is therefore also barred as a matter of equity under 15 U.S.C. § 1125(c) and should be refused under 15 U.S.C. § and 1063(a).

17. Accordingly, Opposer prays that said Application Serial Number 78/245,210 be rejected and that registration of the mark therein shown for the goods therein specified be refused and denied.

This Notice of Opposition is herewith submitted in triplicate, together with the filing fee in the amount of \$300. If the fees enclosed are not sufficient, or if any additional fees are required, the Patent and Trademark Office is hereby authorized to charge our USPTO Deposit Account Number 502843 in the name of Nelson Mullins Riley & Scarborough LLP.

Respectfully submitted this 14<sup>th</sup> day of March, 2005.



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N.C. Bar No. 1887

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Dallas, TX 75201

Attorney for Opposer

## **EXHIBIT F**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of )  
 )  
Application Serial Number 79/000,478 )  
 )  
Mark: So DB )  
 )  
Published: May 3, 2005 )  
 )  
De Boulle Diamond & Jewelry, Inc., )  
Opposer, )  
 )  
v. )  
De Beers LV Ltd )  
Applicant )

NOTICE OF OPPOSITION

De Boulle Diamond & Jewelry, Inc., a corporation organized and existing under the laws of the state of Texas and having its principal place of business at 6821 Preston Road, Dallas, TX 75205, (hereinafter "De Boulle" or "Opposer"), believes that it will be damaged by registration of the mark shown in application Serial Number 79/000,478 in International Class 014, and hereby opposes the same.

The opposition is based on 15 U.S.C. § 1063(a), and the grounds for this opposition are as follows:

<p>CERTIFICATE OF MAILING BY "EXPRESS MAIL" "Express Mail" mailing label number EV409767691US</p> <p>I hereby certify that this correspondence is addressed to the Commissioner For Trademarks, P.O. Box 1451, Alexandria, Virginia 22313, BOX TTAB - FEE, and is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 3 CFR 1.10 on the date noted below.</p> <p>Kathlyn Hunter Name of person mailing paper or fee</p> <p><i>Kathlyn Hunter</i> (Signature of person mailing paper or fee)</p> <p>May 13, 2005 (Date of signature)</p>
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1. De Beers LV Ltd., a limited liability company organized under the laws of the United Kingdom (hereinafter "De Beers" or "Applicant") seeks to register its mark So DB as a trademark for the following goods in International Class 014 (hereinafter "Applicant's Goods"), as evidenced by publication of said Mark in the Official Gazette on page TM 386 of the May 3, 2005 issue:

In International Class 014 for precious metals and their alloys and goods in precious metals or coated therewith, namely, beverage glassware and dishes of precious metal, candle snuffers and candlesticks of precious metal, napkins rings of precious metal, vases of precious metal, jewel cases of precious metal, statues of precious metal, rings, necklaces, bracelets, earrings, brooches, diadems made of precious metals or coated therewith, jewelry and imitation jewelry, gemstones; precious stones; semi-precious stones, diamonds, watches, clocks; horological and chronometric instruments, namely, chronometers, chronographs for use as watches, watch bracelets, watch cases, pocket watches, wristwatches, watch movements; replacement parts for all the aforesaid goods.

2. Applicant acquired no rights in Applicant's mark in the United States prior to November 25, 2003, when Applicant filed its Intent to Use application for Applicant's So DB mark in the United States Patent and Trademark Office with a Madrid Protocol claimed priority date of August 26, 2003.

3. Prior to the filing date for Applicant's Mark, and any priority date or date of use which Applicant can rely on, Opposer has for many years used "DB" and "deB" marks for the following goods (hereinafter "Opposer's Goods"):

In International Class 014 Jewelry, diamonds, watches and timepieces, and fine art.

In International Class 035 Retail jewelry store services via physical store, catalogue sales and web-based sales.

4. Opposer has used the mark DB since at least as early as December 31, 2000. This mark is the subject of a pending trademark application filed April 7, 2005, USPTO Serial No. 78/604,056.

5. Opposer has used a particular stylized version of the "deB" mark, which is a "deB" logo, since at least as early as June 30, 2001. This stylized version of the mark is the subject of a pending trademark application filed July 1, 2004, USPTO Serial No. 78/444,907.

6. Opposer has spent substantial amounts of time, money and effort in developing and marketing Opposer's Goods under Opposer's "DB" and "deB" marks in the United States and sales of Opposer's Goods under Opposer's "DB" and "deB" marks have amounted to many millions of dollars. As a result, members of the general public have come to identify Opposer's "DB" and "deB" marks with Opposer's Goods and to recognize Opposer's Goods to be of the highest quality and originating from Opposer.

7. Because of Opposer's marketing efforts and sales, Opposer has established a prominent presence in the retail jewelry marketplace as a leading provider of high quality jewelry and timepieces. Through the distinctiveness of Opposer's "DB" and "deB" marks and through widespread and favorable public recognition and acceptance in the retail jewelry market and, in particular, in the area of high quality jewelry, Opposer's "DB" and "deB" marks have become uniquely associated with Opposer and is famous, distinctive and well-known.

8. Applicant's So DB mark is very similar in appearance and commercial impression to Opposer's "DB" and "deB" marks, with the marks having the identical DB or "deB" as the dominant term. Importantly, Applicant's So DB mark and Opposer's "DB" and "deB" marks are for identical goods in International Class 014, namely, jewelry and timepieces. Applicant has, thus, expressed an intent to use Applicant's So DB mark on goods that are identical to Opposer's Goods and/or goods that are within Opposer's natural area of expansion. Particularly, any use of its mark by the Applicant which would emphasize the DB part of its mark and/or de-emphasize the SO part of its mark would result in near identical marks and cause clear and obvious confusion in the marketplace.

9. On information and belief, it is expected that Applicant's Goods will be marketed to the same potential purchasers in the same relevant markets as the goods now marketed by Opposer and/or the goods within Opposer's natural area of expansion. Moreover, it is expected that

Applicant will use similar media to advertise Applicant's Goods under Applicant's So DB mark as used by Opposer to advertise Opposer's Goods under Opposer's "DB" and "deB" marks. Additionally, it is expected that the goods marketed under Applicant's So DB mark will be distributed through the same channels of distribution and will be purchased and used by many of the same individuals and entities as those of the Opposer's Goods.

10. As a result of the substantial similarities between the marks' respective appearances, underlying goods, relevant markets, advertising, channels of distribution, purchasers, and users, Opposer believes that there is a very strong likelihood of confusion if Applicant is permitted to register Applicant's So DB mark for use in conjunction with Applicant's Goods.

11. Opposer's marketing efforts have caused Opposer and Opposer's "DB" and "deB" marks to be well-known and well-regarded in the community of consumers who are likely to consider purchasing Applicant's Goods. Therefore, it is likely that some members of the relevant consumer market would be confused by the marketing of Applicant's Goods under Applicant's So DB mark and would believe that Applicant's Goods were associated with, endorsed by, related to, or actually the goods of Opposer. Any fault or defect in Applicant's Goods would reflect upon and seriously injure Opposer's reputation. Furthermore, individuals or entities who are familiar with Opposer's "DB" and "deB" marks would confuse the same with Applicant's So DB mark and might purchase Applicant's Goods in the mistaken belief that they are purchasing the goods of Opposer.

12. If Applicant is granted the registration herein opposed, Applicant would be placed in a position to deceive or mislead the public, as the registration would give Applicant certain rights to Applicant's So DB mark and all confusingly similar marks, thereby causing damage and injury to Opposer.

13. As a result of the substantial similarities between the marks' respective appearances, underlying goods, relevant markets, advertising, channels of distribution, purchasers, and users, registration of Applicant's So DB mark would cause damage and injury to Opposer.



14. Because Applicant's So DB mark consists of a mark which closely resembles senior marks of Opposer, Applicant's So DB mark is likely, when used in connection with the goods of Applicant, to cause confusion, to cause mistake, or to deceive, and registration of Applicant's So DB mark is therefore barred under 15 U.S.C. § 1052(d).

15. Further, Opposers' "DB" and "deB" marks are distinctive and famous marks within the meaning of same set forth in 15 U.S.C. § 1125(c). The use of Applicant's So DB mark by Applicant as stated in its intent to use application is for a commercial use in interstate commerce beginning after Opposer's "DB" and "deB" marks have become famous, and, given the similarities of the marks, such use by Applicant would cause dilution of the distinctive quality of Opposer's "DB" and "deB" marks by lessening the capacity of Opposer's "DB" and "deB" marks to identify and distinguish goods or services.

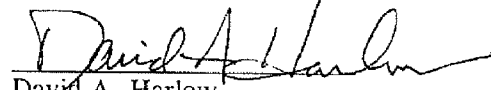
16. Given that Applicant's use of Applicant's So DB mark by Applicant as stated in its intent to use application is for a commercial use in interstate commerce and that such use would dilute the distinctive quality of Opposer's famous "DB" and "deB" marks, registration of Applicant's So DB mark would cause damage and injury to Opposer.

17. Because Applicant's So DB mark consists of a mark which would cause dilution of the distinctive quality of Opposer's "DB" and "deB" marks, registration of Applicant's So DB mark is therefore also barred as a matter of equity under 15 U.S.C. § 1125(c) and should be refused under 15 U.S.C. § and 1063(a).

18. Accordingly, Opposer prays that said Application Serial Number 79/000,478 be rejected and that registration of the mark therein shown for the goods therein specified be refused and denied.

This Notice of Opposition is herewith submitted in triplicate, together with the filing fee in the amount of \$300. If the fees enclosed are not sufficient, or if any additional fees are required, the Patent and Trademark Office is hereby authorized to charge our USPTO Deposit Account Number 502843 in the name of Nelson Mullins Riley & Scarborough LLP.

Respectfully submitted this 13<sup>th</sup> day of May, 2005.



David A. Harlow  
N.C. Bar No. 1887  
NELSON MULLINS RILEY  
& SCARBOROUGH LLP

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Pieter J. Tredoux, Esq.  
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Dallas, TX 75201  
Attorney for Opposer

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of	)
	)
Application Serial Number 78/245,795	)
	)
Mark: DB STAR	)
	)
Published: May 3, 2005	)
	)
De Boulle Diamond & Jewelry, Inc.,	)
Opposer,	)
	)
v.	)
De Beers LV Ltd	)
Applicant	)

**NOTICE OF OPPOSITION**

De Boulle Diamond & Jewelry, Inc., a corporation organized and existing under the laws of the state of Texas and having its principal place of business at 6821 Preston Road, Dallas, TX 75205, (hereinafter "De Boulle" or "Opposer"), believes that it will be damaged by registration of the mark shown in application Serial Number 78/245,795 in International Class 014, and hereby opposes the same.

The opposition is based on 15 U.S.C. § 1063(a), and the grounds for this opposition are as follows:

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I hereby certify that this correspondence is addressed to the Commissioner For Trademarks, P.O. Box 1451, Alexandria, Virginia 22313, BOX TTAB - FEE, and is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 3 CFR 1.10 on the date noted below.

Kathlyn Hunter

Name of person mailing paper or fee

(Signature of person mailing paper or fee)

May 17, 2005

(Date of signature)

1. De Beers LV Ltd., a limited liability company organized under the laws of the United Kingdom (hereinafter "De Beers" or "Applicant") seeks to register its mark DB STAR as a trademark for the following goods in International Class 014 (hereinafter "Applicant's Goods"), as evidenced by publication of said Mark in the Official Gazette on page TM 379 of the May 3, 2005 issue:

In International Class 014 for precious metals and their alloys and goods in precious metals or coated therewith, namely, beverage glassware and dishes of precious metal, candle snuffers and candlesticks of precious metal, napkins rings of precious metal, vases of precious metal, jewel cases of precious metal, statues of precious metal, rings, necklaces, bracelets, earrings, brooches, diadems made of precious metals or coated therewith, jewelry and imitation jewelry, gemstones; precious stones, semi-precious stones, diamonds, watches, clocks; horological and chronometric instruments, namely, chronometers, chronographs for use as watches, watch bracelets, watch cases, pocket watches, wristwatches, watch movements; replacement parts for all the aforesaid goods.

2. Applicant acquired no rights in Applicant's mark in the United States prior to May 5, 2003, when Applicant filed its Intent to Use application for Applicant's DB STAR mark in the United States Patent and Trademark Office with a Section 44(d) claimed priority date from a United Kingdom application filed November 15, 2002.

3. Prior to the filing date for Applicant's Mark, and any priority date or date of use which Applicant can rely on, Opposer has for many years used "DB" and "deB" marks for the following goods (hereinafter "Opposer's Goods"):

In International Class 014 Jewelry, diamonds, watches and timepieces, and fine art.

In International Class 035 Retail jewelry store services via physical store, catalogue sales and web-based sales.

4. Opposer has used the mark DB since at least as early as December 31, 2000. This mark is the subject of a pending trademark application filed April 7, 2005, USPTO Serial No. 78/604,056.

5. Opposer has used a particular stylized version of the "deB" mark, which is a "deB" logo, since at least as early as June 30, 2001. This stylized version of the mark is the subject of a pending trademark application filed July 1, 2004, USPTO Serial No. 78/444,907.
6. Opposer has spent substantial amounts of time, money and effort in developing and marketing Opposer's Goods under Opposer's "DB" and "deB" marks in the United States and sales of Opposer's Goods under Opposer's "DB" and "deB" marks have amounted to many millions of dollars. As a result, members of the general public have come to identify Opposer's "DB" and "deB" marks with Opposer's Goods and to recognize Opposer's Goods to be of the highest quality and originating from Opposer.
7. Because of Opposer's marketing efforts and sales, Opposer has established a prominent presence in the retail jewelry marketplace as a leading provider of high quality jewelry and timepieces. Through the distinctiveness of Opposer's "DB" and "deB" marks and through widespread and favorable public recognition and acceptance in the retail jewelry market and, in particular, in the area of high quality jewelry, Opposer's "DB" and "deB" marks have become uniquely associated with Opposer and is famous, distinctive and well-known.
8. Applicant's DB STAR mark is very similar in appearance and commercial impression to Opposer's "DB" and "deB" marks, with the marks having the identical DB or "deB" as the dominant term. Importantly, Applicant's DB STAR mark and Opposer's "DB" and "deB" marks are for identical goods in International Class 014, namely, jewelry and timepieces. Applicant has, thus, expressed an intent to use Applicant's DB STAR mark on goods that are identical to Opposer's Goods and/or goods that are within Opposer's natural area of expansion. Particularly, any use of its mark by the Applicant which would emphasize the DB part of its mark and/or de-emphasize the STAR part of its mark would result in near identical marks and cause clear and obvious confusion in the marketplace.
9. On information and belief, it is expected that Applicant's Goods will be marketed to the same potential purchasers in the same relevant markets as the goods now marketed by Opposer and/or the goods within Opposer's natural area of expansion. Moreover, it is expected that

Applicant will use similar media to advertise Applicant's Goods under Applicant's DB STAR mark as used by Opposer to advertise Opposer's Goods under Opposer's "DB" and "deB" marks. Additionally, it is expected that the goods marketed under Applicant's DB STAR mark will be distributed through the same channels of distribution and will be purchased and used by many of the same individuals and entities as those of the Opposer's Goods.

10. As a result of the substantial similarities between the marks' respective appearances, underlying goods, relevant markets, advertising, channels of distribution, purchasers, and users, Opposer believes that there is a very strong likelihood of confusion if Applicant is permitted to register Applicant's DB STAR mark for use in conjunction with Applicant's Goods.

11. Opposer's marketing efforts have caused Opposer and Opposer's "DB" and "deB" marks to be well-known and well-regarded in the community of consumers who are likely to consider purchasing Applicant's Goods. Therefore, it is likely that some members of the relevant consumer market would be confused by the marketing of Applicant's Goods under Applicant's DB STAR mark and would believe that Applicant's Goods were associated with, endorsed by, related to, or actually the goods of Opposer. Any fault or defect in Applicant's Goods would reflect upon and seriously injure Opposer's reputation. Furthermore, individuals or entities who are familiar with Opposer's "DB" and "deB" marks would confuse the same with Applicant's DB STAR mark and might purchase Applicant's Goods in the mistaken belief that they are purchasing the goods of Opposer.

12. If Applicant is granted the registration herein opposed, Applicant would be placed in a position to deceive or mislead the public, as the registration would give Applicant certain rights to Applicant's DB STAR mark and all confusingly similar marks, thereby causing damage and injury to Opposer.

13. As a result of the substantial similarities between the marks' respective appearances, underlying goods, relevant markets, advertising, channels of distribution, purchasers, and users, registration of Applicant's DB STAR mark would cause damage and injury to Opposer.

14. Because Applicant's DB STAR mark consists of a mark which closely resembles senior marks of Opposer, Applicant's DB STAR mark is likely, when used in connection with the goods of Applicant, to cause confusion, to cause mistake, or to deceive, and registration of Applicant's DB STAR mark is therefore barred under 15 U.S.C. § 1052(d).

15. Further, Opposers' "DB" and "deB" marks are distinctive and famous marks within the meaning of same set forth in 15 U.S.C. § 1125(c). The use of Applicant's DB STAR mark by Applicant as stated in its intent to use application is for a commercial use in interstate commerce beginning after Opposer's "DB" and "deB" marks have become famous, and, given the similarities of the marks, such use by Applicant would cause dilution of the distinctive quality of Opposer's "DB" and "deB" marks by lessening the capacity of Opposer's "DB" and "deB" marks to identify and distinguish goods or services.

16. Given that Applicant's use of Applicant's DB STAR mark by Applicant as stated in its intent to use application is for a commercial use in interstate commerce and that such use would dilute the distinctive quality of Opposer's famous "DB" and "deB" marks, registration of Applicant's DB STAR mark would cause damage and injury to Opposer.

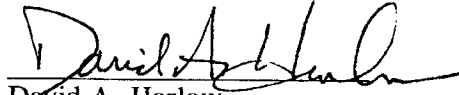
17. Because Applicant's DB STAR mark consists of a mark which would cause dilution of the distinctive quality of Opposer's "DB" and "deB" marks, registration of Applicant's DB STAR mark is therefore also barred as a matter of equity under 15 U.S.C. § 1125(c) and should be refused under 15 U.S.C. § and 1063(a).

18. Accordingly, Opposer prays that said Application Serial Number 78/245,795 be rejected and that registration of the mark therein shown for the goods therein specified be refused and denied.

This Notice of Opposition is herewith submitted in triplicate, together with the filing fee in the amount of \$300. If the fees enclosed are not sufficient, or if any additional fees are

required, the Patent and Trademark Office is hereby authorized to charge our USPTO Deposit Account Number 502843 in the name of Nelson Mullins Riley & Scarborough LLP.

Respectfully submitted this 13<sup>th</sup> day of May, 2005.



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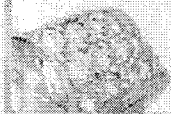
Attorney for Opposer



## **EXHIBIT G**

# deBoule

when it is time for something special :)



## Welcome to deBoule.com

You are about to experience the beauty, quality and fine craftsmanship of the deBoule Collection. Until now, this world-class array of diamonds, fine jewelry and timepieces has been available only to the loyal clientele of our salon in Dallas, Texas.

Over the past two decades, deBoule has built a reputation as one of the pre-eminent, independently-owned jewelers in the United States. deBoule is renowned for the beauty, quality and fine craftsmanship of its collection.

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FINE JEWELRY

TIMEPIECES

ACCESSORIES

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*The deBoule Collection*

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JEWELER'S GUIDE



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D-FLAWLESS  
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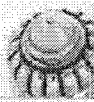


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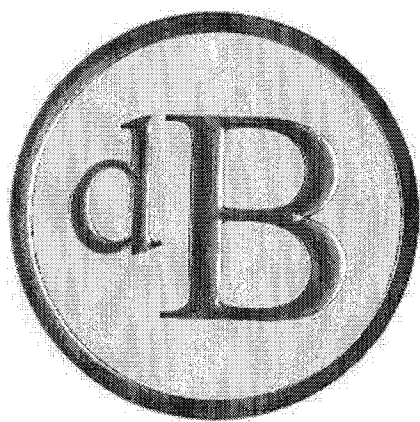


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## **EXHIBIT H**

Boullé



\*Bouille

